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IN THE

Supreme Court of the United States

OCTOBER TERM, 1974

No. 74-727

NORMAN H. GRANT, ET AL., *Petitioners*

v.

HERBERT H. SILVESTRI, ET AL., *Respondents*

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

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PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

Petitioners respectfully pray that a writ of certiorari issue to review the judgment and opinion of the United States Court of Customs and Patent Appeals entered on May 9, 1974 in Appeal No. 8978 entitled *Silvestri et al* v. *Grant et al*, and that that Court's denials (on September 12, 1974) of a timely filed petition for rehearing and a motion to remand to the Board of Patent Interferences be reversed.

OPINIONS BELOW

The opinion of the United States Court of Customs and Patent Appeals, reprinted in Appendix B, is reported at 496 F.2d 593 (CCPA 1974). The unreported

opinion of the Patent Office Board of Patent Interferences is reprinted in Appendix C. The petition for rehearing and the motion to remand were denied without opinion.

JURISDICTION

The judgment of the United States Court of Customs and Patent Appeals (Appendix B) was entered on May 9, 1974. A timely petition for rehearing was denied on September 12, 1974 (Appendix F), and this petition is being filed within 90 days thereof. The jurisdiction of this Court is invoked under 28 U.S.C. § 1256.

QUESTIONS PRESENTED

1. What is the proper role of the United States Court of Customs and Patent Appeals ("CCPA") in reviewing decisions of the Board of Patent Interferences under 35 U.S.C. §§ 141-144?

2. Can the CCPA independently make findings of fact on issues left undecided by the Board, or must it (or should it) leave to the Board the responsibility for initial fact finding?

STATUTORY PROVISIONS INVOLVED

In pertinent part, the statutes principally involved are the following:

35 U.S.C. § 102:

"A person shall be entitled to a patent unless—

* * * * * *

(g) before the applicant's invention thereof the invention was made in this country by another *who had not abandoned, suppressed, or concealed it.*" [Emphasis added.]

35 U.S.C. § 141:

"... A party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority may appeal to the United States Court of Customs and Patent Appeals, ..."

35 U.S.C. § 142:

"When an appeal is taken to the United States Court of Customs and Patent Appeals, the appellant shall give notice thereof to the Commissioner, *and shall file in the Patent Office his reasons of appeal, specifically set forth in writing ...*" [Emphasis added.]

35 U.S.C. § 144:

"The United States Court of Customs and Patent Appeals, on petition, shall hear and determine such appeal on the evidence produced before the Patent Office *and the decision shall be confined to the points set forth in the reasons of appeal.*" [Emphasis added.]

The foregoing and other statutes referred to throughout this petition are reprinted in Appendix A.

STATEMENT OF THE CASE

Petitioners are employees of American Home Products Corporation who received a patent in 1964 on a form of ampicillin, a semi-synthetic form of penicillin. Ampicillin is more broadly effective than natural forms of penicillin and is superior to tetracycline because it is less toxic, less productive of side-effects, and is effective by actually killing rather than merely inhibiting the growth of target disease-causing bacteria. Ampicillin is produced commercially in two forms: the crystalline anhydrous form (essentially having a very low moisture content) marketed by American

Home Products, and a trihydrate form in which the ampicillin molecule is chemically bound to three molecules of water. This latter form of ampicillin is marketed by, among others, Bristol-Myers Co., assignee of the respondents in this case.

In a complaint filed in 1970 against Bristol-Myers and the Beecham Group (Bristol-Myers' British licensor of the basic ampicillin patent rights), the Justice Department alleged that world-wide sales of the drug in 1968 by Bristol-Myers, Beecham, and their licensees approximated $170 million and in the United States approximated $85 million. Complaint in *U.S. v. Bristol-Myers Co., et al*, C.A. 882-80, D.D.C. (1970), at p. 5.

Data published this year by the U. S. Tariff Commission[1] indicates that in 1972 bulk sales of all forms of ampicillin were about $30 million. This figure excludes "captive uses" by producers of the bulk form who also manufacture finished pharmaceuticals. According to the same source, such uses account for almost 60 per cent of all U. S. production. A Census Bureau report[2] groups natural and synthetic forms of penicillin and reflects 1972 sales by all U. S. producers of that finished line of products at the wholesale level at $210 million. Extrapolating from the Tariff Commission's figures indicating that ampicillin accounts for about 60 per cent of all types of penicillin

[1] U. S. Tariff Commission, "United States Productio.. and Sales of Medicinal Chemicals", Table 1: Medicinal Chemicals, U. S. Production and Sales, 1972 (Prelim. Print, 1974).

[2] Bureau of Census, "Pharmaceutical Preparations, Except Biologicals, 1972" Series MA-28G (72)-1, Table 1, Value of Shipments of Pharmaceutical Preparations, except Biologicals, p. 5 (1973).

produced for non-captive uses, it would appear that the wholesale market for ampicillin in all forms during 1972 was about $120 million. Petitioners' assignee believes that its form of anhydrous ampicillin accounts for about 16 per cent of this market.

Current assessment of the market would no doubt reveal production and sales figures substantially higher than those reported above. But even these few publicly available documents concerning the size of the market indicate the importance of ampicillin in one form or another to the health and the commerce of the United States.[3]

Petitioners developed their anhydrous form of ampicillin in a quest to obtain longer shelf-life for the drug. In the non-anhydrous form in which ampicillin had been originally developed by employees of the Beecham Group in England, the drug tended to lose effectiveness rather quickly on storage or when exposed to elevated temperatures. Petitioners' application for a patent on their form of anhydrous ampicillin was filed on December 26, 1962 and issued on August 11, 1964 as U. S. Patent No. 3,144,445.

During this period in the early 1960's, American Home Products was, of course, not alone in its efforts to develop an ampicillin with a shelf-life longer than was then being produced under the basic Beecham patent [4] (under which American Home Products was a licensee). Employees of Bristol-Myers, including respondents, were also attempting to develop such a

[3] *Chemical & Engineering News* for November 11, 1973, p. 7, reported a study showing that ampicillin is now the second most widely prescribed generic drug in the United States.

[4] Doyle et al U. S. Patent No. 2,985,648, granted May 23, 1961.

product. Respondents' research on ampicillin resulted in an application for patent filed on October 29, 1962,[5] which, however, did not disclose an anhydrous form of the drug. It was only following the issuance of the '445 patent to petitioners, in August of 1964, that respondents were, in the words of both the Patent Office Board of Patent Interferences and the CCPA, spurred or moved into filing their application in an attempt also to obtain a patent on the anhydrous form described and claimed in petitioners' '445 patent.[6] Accordingly, a so-called continuation-in-part application for a patent was filed on November 2, 1964 in which for the first time respondents claimed to have invented an anhydrous form.

The Patent Office then declared an interference pursuant to 35 U.S.C. § 135 to determine whether petitioners' issued patent or respondents' later-filed application was entitled to priority. In the proceedings before the Board of Patent Interferences respondents were the junior party (i.e., the party having the later filing date) and, accordingly, had the burden of proving beyond a reasonable doubt that they, and not the petitioners, were the first actually to reduce to practice the invention described and claimed in petitioners' patent. Petitioners argued that the evidence presented by respondents was insufficient to demonstrate that they had in fact "actually reduced to practice" that invention. They contended that while respondents had done some work with a low-moisture ampicillin, they had not actively pursued that effort, and only upon the

[5] That application resulted in the issuance to them of U. S. Patent No. 3,180,862 on April 27, 1965.

[6] See the admissions by respondents' attorney Brink, Appendix E.

issuance of petitioners' patent had begun to appreciate for the first time that their earlier incompleted efforts might have led to useful results. The Board of Patent Interferences was unanimous in accepting petitioners' arguments. It found that respondents had not proven beyond a reasonable doubt that they had "actually reduced to practice" within the meaning of the patent law the anhydrous ampicillin described and claimed in petitioners' patent.

In the light of that decision favorable to petitioners, the Board declined to rule on a further argument presented by petitioners on the second of the two major issues before the Board. Petitioners had contended alternatively that even if respondents had achieved an actual reduction to practice prior to petitioners' filing date in 1962, respondents' failure to take any affirmative steps to obtain a patent on that invention until after petitioners' patent has issued amounted to a statutory bar within the meaning of 35 U.S.C. § 102(g), since respondents had "abandoned, suppressed or concealed" their alleged invention. Evidence in support of this position was introduced; but, as indicated, the Board did not consider that evidence beyond noting, in connection with its resolution of the first issue, that respondents were "spurred into filing" by the issuance of petitioners' patent after having allowed their alleged invention to lie dormant (except for some routine in-house shelf-life testing conducted with respect to some experimental samples as was simultaneously done with many other experimental products by the Bristol-Myers research department).

Since petitioners prevailed before the Board, they naturally did not (and indeed could not[7]) appeal to

[7] *Klemperer* v. *Price*, 271 F.2d 743 (CCPA 1959).

the CCPA, nor did they seek review in the District Court. Respondents selected the CCPA as the forum for appeal and, of course, appealed with respect to the issue on which the Board had ruled adversely as to them. They did not include as a reason of appeal amongst their more than fifty reasons of appeal the Board's failure to make a finding on petitioners' § 102(g) argument. Nevertheless, at page 43 of their opening Brief before the CCPA, respondents did discuss their disagreement with the Board's statement concerning the effect on their actions of the issuance of petitioners' patent and asserted that the evidence adduced below would not support a finding that they had abandoned, suppressed or concealed their invention.

Petitioners dared not ignore the arguments presented almost as an aside in respondents' opening brief in the CCPA, and so in their answering brief offered argument on the issue despite the absence of any relevant finding by the Board or the inclusion of that issue in respondents' Notice of Appeal[8] to which the statute confines the CCPA's authority to render judgment.

The CCPA reversed the decision of the Board on the issue of respondents' actual reduction to practice. It held that respondents had proved the necessary conception and actual reduction to practice. Beyond that, while recognizing that the Board had not passed directly on the entirely separate and distinct issues under § 102(g), the CCPA itself became a finder of facts in the first instance and determined that petitioners had not adequately demonstrated respondents' abandonment, suppression or concealment. Petition-

[8] For excerpts, see Appendix D.

ers timely brought to the attention of the CCPA that the Court generally would not, and certainly should not, become an initial finder of facts on such critical alternative issues. They asked the CCPA to remand the case to the Board for further proceedings to enable it to make appropriate initial findings of fact based on the Board's special expertise in this difficult and complex area of patent law, which it was (and is) petitioners' view is the unique responsibility of the Board. Nevertheless, the CCPA declined to remand and petitioners have, accordingly, filed this petition for a writ of certiorari as their one and only opportunity to obtain judicial review of an initial fact finding made at the appellate level that obviously is critical to this important patent.

If unreviewed and unreversed, the effect of the CCPA's decision may be to prolong the existence of a patent monopoly on this commercially important form of ampicillin from seventeen to twenty-eight years.[9]

REASONS FOR GRANTING THE WRIT

This case presents classic grounds for the grant of a writ of certiorari: The CCPA has acted on an important procedural aspect of federal law which has not been, but should be, settled by this Court; it has rendered a decision conflicting with decisions of the United States Courts of Appeals; and it has so far departed

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[9] Petitioners' patent was issued on August 11, 1964 and will, accordingly, expire seventeen years later, in 1981. If the decision of the CCPA remains unreversed, respondents may be granted a patent on the same invention which would presumably not issue before mid-1975 at the earliest and would, thus, not expire until 1992.

from the usual course of judicial proceedings as to call for an exercise of this Court's power of supervision.

I. THIS IS A CASE OF FIRST IMPRESSION. IT REQUIRES AN INTERPRETATION OF A KEY PROVISION OF THE PATENT ACT NEVER BEFORE CONSIDERED BY THIS COURT.

The Court of Customs and Patent Appeals plays an important role in the American judicial system. Since this Court's decisions in *Lurk* v. *United States*, 370 U.S. 350 (1962), and *Brenner* v. *Manson*, 383 U.S. 519 (1966), it is now clear that the CCPA is established under Article III of the Constitution and is coordinate with the United States Courts of Appeals in exercising appellate jurisdiction. With respect to the operation of the patent laws, the CCPA's role is essentially twofold: it reviews the decisions of the Board of Appeals in *ex parte* cases in which an applicant for a patent has been denied a patent, and it reviews the decisions of the Board of Patent Interferences in priority-of-invention contests between applicants (or, as here, between an applicant and a patentee) who claim a patent on the same invention.

This Court has granted a writ of certiorari to review a decision of the CCPA in a patent case on only three occasions. Each of those cases arose from *ex parte* prosecution. In the only two such cases decided,[10] the Court found it necessary and proper to reverse the judgment of the CCPA and to reinstate the decision of the Patent Office tribunal. *Brenner* v. *Manson*, 383 U.S. 519 (1966) (holding that the patentability of a process for making a chemical compound

[10] The third was dismissed upon the respondents' suggestion of mootness. *Brenner* v. *Hofstetter*, 389 U.S. 5 (1967).

requires a showing of utility for the compound); *Gottschalk* v. *Benson*, 409 U.S. 63 (1972) (holding that a method for computer programming is non-patentable).

This Court has never reviewed a decision of the CCPA involving an appeal from a determination of the Board of Patent Interferences.[11] This is, however, no less important a function of the CCPA than its role in deciding appeals from the Board of Appeals.[12] At least twenty percent of its current patent docket involves such cases.[13] The CCPA's decisions in inter-

[11] This Court has also only reviewed a single patent case from the Patent Office in turn reviewed by the District Court since the adoption of the Patent Act of 1952 and that, too, involved an *ex parte* decision by the Board of Appeals. *Hazeltine Research, Inc.* v. *Brenner*, 382 U.S. 252 (1965).

[12] The jurisdiction of the CCPA also involves a variety of other matters including, of course, customs issues and trademark questions. For a general discussion of the Court's jurisdiction see Gholz, "Patent and Trademark Jurisdiction of the CCPA", 37 Geo. Wash. L. Rev. 416 (1972).

[13] Published statistics for the past six years concerning the CCPA's decisions arising from the two Patent Office Board show:

Fiscal Year	Board of Appeals	Board of Patent Interferences
1969	123	24
1970	119	21
1971	148	23
1972	87	21
1973	72	18
1974	76	24

Sources: 4A Dunner, Court Review of Patent Office Decisions: CCPA § 8.03(f), Table 1 (1973) (for years 1969-72); decisions reported in USPQ volumes 174 through 181 for 1973-74 (The USPQ does not report all decisions of the Court, although all were presumably included in the figures cited by Dunner.)

ference cases can have, as it would here, the effect of prolonging the patent monopoly on a claimed invention from seventeen to more than twenty-eight years. Clearly this significant feature of the jurisdiction of the CCPA should be examined by this Court so that the CCPA's decisions are consistent with each other, with decisions of the coordinate United States Courts of Appeals, and with this Court's interpretations of the Patent Act of 1952.

Although the first Patent Act dates back to 1790, no statutory provision for direct appeal to the courts from Patent Office decisions existed until the Patent Act of 1839. However, until 1927 such appeals were considered "interlocutory" and so did not reach this Court on the merits. See *Frasch* v. *Moore*, 211 U.S. 1 (1908). Following creation of the CCPA in 1929, this Court held that an appeal from the CCPA was not a "case" within the meaning of Article III of the Constitution. *Postum Cereal Co.* v. *California Fig Nut Co.*, 272 U.S. 693 (1927) (a trademark case). This want of jurisdiction was reaffirmed in the patent interference context in *McBride* v. *Teeple*, 311 U.S. 649 (1940). Only after Congress amended the Judicial Code specifically to provide that the CCPA "is hereby declared to be a court established under Article III of the Constitution of the United States," 28 U.S.C. § 211, and *Lurk* and *Manson* were decided by this Court in 1962 and 1966, has it been clear that an issue such as is presented by the present case can be considered on its merits by this Court. Thus, for the first time in the nearly two-hundred year history of patent laws in this country the Court can — and petitioners suggest should — consider this important aspect of the administration of the patent system. Indeed, this Court may wish to con-

sider inviting the Solicitor General to express the views of the United States on such an important matter.

II. THE DECISION BELOW CONFLICTS WITH THE DECISIONS OF COORDINATE UNITED STATES COURTS OF APPEALS AND WITH THE PRIOR DECISIONS OF THE CCPA.

A. The Decision is Inconsistent with the Standard of Review Applied by the Coordinate United States Courts of Appeals.

A party dissatisfied with a decision of the Board of Patent Interferences may seek review by appeal to the CCPA or through an action commenced in a United States District Court under 35 U.S.C. § 146. A decision of the latter court is, of course, appealable to the appropriate United States Court of Appeals. A similar bifurcated avenue for review of *ex parte* decisions by the Board of Appeals exists by virtue of 35 U.S.C. § 145. As this Court noted in *Brenner* v. *Manson, supra*, at 527 (an *ex parte* case arising out of an appeal to the CCPA from the Board of Appeals), the orderly administration of the patent laws requires that the ultimate outcome of issues of law be identical regardless of the method chosen to review the decisions of the Board. It would make no sense for the law to allow different results on legal issues to depend upon the court system selected by the appellant.

In delineating their role in reviewing cases from the District Courts, the United States Courts of Appeals have consistently done so in terms of the traditional criteria of the Federal Rules of Civil Procedure, Rule 52(a), according to which only a "clearly erroneous" fact finding can be set aside by the Court of Appeals, but no *initial* findings of fact may be made by the appellate tribunal.

In the broadly analogous situation in which a United States Court of Appeals reviews a District Court de-

cision that has ruled on only one of the two-prolonged defenses of invalidity and noninfringement of a patent, the appellate court will, if it reverses the lower court, remand for findings of fact on the other issue. To avoid this problem, the United States Courts of Appeals have encouraged the lower courts to make findings of fact and render conclusions of law on both the issues of validity and infringement, so that if the appellate court reverses on one major issue, it can immediately proceed to a resolution of the other based on appropriate findings of fact already made by the District Court. For cases illustrating the general principle, see, e.g., *Welsh Co. of California* v. *Strolee of California, Inc.*, 290 F.2d 509 (9 Cir. 1961); *Helbush* v. *Finkle*, 170 F.2d 41 (9 Cir. 1948); *National Lead Co.* v. *Western Lead Products Co.*, 291 F.2d 447 (9 Cir. 1961); *Johnson & Johnson* v. *Carolina Lee Knitting Co.*, 258 F.2d 593 (4 Cir. 1958); *Coe Mfg. Co.* v. *Jeddeloh Bros. Sweed Mills, Inc.*, 306 F.2d 455 (9 Cir. 1962); *Fromberg, Inc.* v. *Thornhill*, 315 F.2d 407 (5 Cir. 1963); *California Research Corp.* v. *Ladd*, 356 F.2d 813 (D.C. Cir. 1966).

In cases arising from the Board of Appeals in which a decision on more than one issue is required and may be appealed to the CCPA, that Court has also generally followed this salutary practice. See, e.g., *In re Chilowsky*, 229 F.2d 456 (CCPA 1956); *In re Herrick*, 344 F.2d 713 (CCPA 1965); *In re Frilette*, 423 F.2d 1397 (CCPA 1970). For unknown reasons in this case it did not. But in exercising its proper role as an appellate court, the CCPA should be held to the review procedures consistently applied by the United States Courts of Appeals. It should *review*, not make,

findings of fact by the body entrusted by law to make them.

B. The Decision Below Is Inconsistent with Prior Decisions of the CCPA.

In reviewing decisions from the Board of Patent Interferences, the CCPA has long recognized that an appellant must rely on "the evidence produced before the Patent Office." By statute the CCPA can only review the Board's ruling on a closed record. 35 U.S.C. § 144. As befits an appellate court, that statute provides that the CCPA

> "shall hear and determine such appeal on the evidence produced before the Patent Office, and the decision shall be confined to the points set forth in the reasons of appeal."

Therefore, when presented with a separate and independent major issue on which the Board did not rule—particularly one turning on an appraisal of highly technical factual evidence—the CCPA generally does, and certainly should, remand the case to the Board for further proceedings. See, e.g., the recent decisions in *Myers* v. *Feigelman*, 455 F.2d 596 (CCPA 1972), and *Snitzer* v. *Etzel*, 465 F.2d 899 (CCPA 1972). In both of those cases the CCPA remanded to the Board of Patent Interferences to enable the Board to launch what the CCPA referred to as a "fully focused inquiry" on a difficult question which the Board had not initially decided. The present case is clearly one requiring the same kind of fully focused inquiry by the primary fact finding tribunal. There is no reason why the CCPA should have treated petitioners in 1974 differently from the parties before it in *Myers* and *Snitzer* in 1972.

III. THE DECISION OF THE CCPA IS AN UNUSUAL DEPARTURE FROM THE NORMAL PROCEDURES OF APPELLATE REVIEW AND OF THE STANDARDS OF REVIEW THIS COURT SHOULD IMPOSE.

The ever-expanding workload of this Court requires no description here. Whatever one's views on the problem or remedy, it seems clear that it would be counterproductive to the goal of preserving access to the Supreme Court for all litigants raising "cert-worthy" issues if this Court had to assume the role of a court of errors and appeals in cases decided by the CCPA. That is not the proper function of this Court. However, if the CCPA is empowered to make initial findings of fact, litigants have little choice but to petition this Court for their first and only opportunity for appellate review. Petitioners do not urge the Court to accept this case simply to correct the error committed below. They do urge the Court to take it so that the CCPA can be instructed on *its* appropriate role in the judicial hierarchy and thus relieve this Court of an inappropriate function.

After the CCPA acquired jurisdiction over patent appeals in 1929, it vacillated for a time on its proper role. But in 1932 it ruled that its authority is limited to correcting such errors as are made by the patent tribunals appealed from and which are definitely pointed out and complained of in the reasons of appeal. *In re Tucker*, 54 F.2d 815 (CCPA 1932).

In *In re Mooney*, 97 F.2d 144 (CCPA 1938), a unanimous CCPA stated that,

> "We are not at liberty to affirm the decision of the Board of Appeals upon the ground urged by the Solicitor, above quoted, for such ground of

> rejection was not relied upon either by the Examiner or the Board of Appeals." 97 F.2d at 147

See also *In re Kaltec*, 316 F.2d 747 (CCPA 1963).

And in a recent customs case, *National Polychemicals Inc.* v. *U. S.*, 433 F.2d 1327 (CCPA 1970), the CCPA specifically restated:

> "We are an appellate court, not a trier of facts, and our review of a determination of fact by the Customs Court is limited to deciding whether there is evidence to support its determination and whether its determination is clearly contrary to the weight of the evidence." 433 F.2d at 1330.

That approach is fully consistent with the teachings of this Court on the proper function of an appellate court.

In *Manufacturers' Finance Co.* v. *McKey*, 294 U.S. 442 (1935), this Court, after reversing the Court of Appeals on the point on which the decrees of the lower court rested, then proceeded to point out that the question or extent of the petitioners' legal rights on another point had been neither determined nor considered upon the facts or the applicable law. The Court stated that,

> "The duty and responsibility of that consideration and determination lie primarily with the lower courts; and. . . . should not, we think, be assumed in the first instance by this court." 294 U. S. at 453.

This Court reversed and remanded for further proceedings in the District Court.

In *Zenith Radio Corp. v. Hazeltine Research Inc.*, 401 U.S. 321, reh. den. 401 U.S. 1015 (1971), this Court noted that the question of damages sustained by Zenith in the Canadian market was not considered by the trial judge. It pointedly remarked that ". . . the trial judge made no such findings as to Canada, and we lack power to make them for him." 401 U.S. at 340, n. 8.

Quite aside from the normal propriety of such a role for an appellate court, the CCPA is subject to a statutory injunction that its decision "*shall* be confined to the points set forth in the reasons of appeal." [Emphasis added] 35 U.S.C. § 144. Respondents' more than fifty reasons of appeal, including eighteen claiming error in the failures of the Board to rule or make findings in respondents' favor, nevertheless did not include any mention of the Board's failure to rule on the issues of abandonment, suppression or concealment. To the extent respondents' Reason 51 might by the greatest stretch of a willing imagination also touch on a § 102(g) issue, the CCPA expressly agreed with the Board's finding in *petitioners'* favor (496 F.2d at 597, 602). That Reason 51 read:

> "51. The Board erred in stating that the appearance of the involved Grant patent on the scene was the spur that led to or catalyzed the filing of the involved Silvestri application."

Thus, not only did the CCPA depart from its proper role as an appellate tribunal: It also exceeded its statutory authority in this case by deciding issues not comprised in respondents' notice of appeal.

In sum, in deciding to become at once a trier of fact and in a very real sense, the sole appellate reviewer of

its own decisions,[14] the CCPA has so far departed from the traditional concepts of orderly judicial practice that this Court should exercise its power of supervision to correct the matter. Only in this way can this Court avoid the unjust existence of wholly unreviewable decisions by a tribunal appellate *in name*, but acting *in essence* as a court of first instance. The CCPA itself, in *In re Schneider*, 481 F.2d 1350 (CCPA 1973), gave the best one-sentence statement of petitioners' position here:

> "The Patent Office is the place for initial findings of fact." 481 F.2d at 1356.

Indeed, in petitioners' view, this Court could very conveniently and expeditiously achieve the correct result without further briefing by simply vacating the judgment below with instructions that the case be remanded to the proper forum in the Patent Office for the initial findings of fact on the § 102(g) issues of abandonment, suppression or concealment.[15]

CONCLUSION

This Court has never before heard an *inter partes* appeal in a patent case from the CCPA. In this case the CCPA has departed significantly from the standards of appellate procedure established by this

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[14] The CCPA could review its own decision through a rehearing but, of course, rarely does so and even more rarely revises its prior judgments. And in cases of this type, review by this Court has to date been non-existent. In the words of Mr. Justice Stewart,

> "Justice demands an independent and objective assessment of a [lower tribunal's] appraisal of [its] own conduct . . ." *Coppedge* v. *United States*, 369 U.S. 438, 455-6 (1962) (concurring separately in the context of a criminal appeal).

[15] For recent precedent illustrating such summary disposition on petition for certiorari, see *Camp* v. *Pitts*, 411 U.S. 138, 143 (1973).

Court. Therefore, this case is particularly appropriate for review by this Court.

Petitioners respectfully urge the Court to hear this case on its merits, by issuing a writ of certiorari to the Court of Customs and Patent Appeals.

Respectfully submitted,

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December 1974

APPENDIX

APPENDIX A

THE RELEVANT STATUTES

From Title 28, Judiciary and Judicial Procedure*

§ 211. Appointment and number of judges

The President shall appoint, by and with the advice and consent of the Senate, a chief judge and four associate judges who shall constitute a court of record known as the United States Court of Customs and Patent Appeals. Such court is hereby declared to be a court established under article III of the Constitution of the United States.

As amended Aug. 25, 1958, Pub.L. 85-755, § 1, 72 Stat. 848.

§ 1256. Court of Customs and Patent Appeals; certiorari

Cases in the Court of Customs and Patent Appeals may be reviewed by the Supreme Court by writ of certiorari. June 25, 1948, c. 646, 62 Stat. 928.

From the Patent Act of 1839*

5 STATUTES AT LARGE, 353.

An Act in addition to "An act to promote the progress of the useful arts."

March 3, 1839

§ 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled* . . . .

§ 11. *And be it further enacted*, That in all cases where an appeal is now allowed by law from the decision of the Commissioner of Patents to a board of examiners, provided for in the seventh section of the act to which this is additional, the party, instead thereof, shall have a right to appeal to the Chief Justice of the district court of the

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* 62 Stat. 869.

* From *Deller's Walker on Patents*, 2nd Ed. Vol. 3, pp. 357, 359 (1964).

United States for the District of Columbia, by giving notice thereof to the Commissioner, and filing in the Patent Office, within such time as the Commissioner shall appoint, his reasons of appeal specifically set forth in writing, and also paying into the Patent Office, to the credit of the patent fund, the sum of twenty-five dollars. And it shall be the duty of said Chief Justice, on petition, to hear and determine all such appeals, and to revise such decisions in a summary way, on the evidence produced before the Commissioner, at such early and convenient time as he may appoint, first notifying the Commissioner of the time and place of hearing, whose duty it shall be to give notice thereof to all parties who appear to be interested therein, in such manner as said judge shall prescribe. The Commissioner shall also lay before the said judge all the original papers and evidence in the case, together with the grounds of his decision, fully set forth in writing, touching all the points involved by the reasons of appeal, to which the revision shall be confined. . . . .

From Title 35, Patents*

§ 101. Inventions patentable

* * * * * * * * * *

Whoever invents or discovers any new and useful . . . . composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

§ 102. Conditions for patentability; novelty and loss of right to patent

A person shall be entitled to a patent unless—

* * * * * * * * * *

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. . . .

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* The Patent Act of 1952. 66 Stat. 792.

§ 135. Interferences

Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with . . . any unexpired patent, he shall give notice thereof to the . . . applicant and patentee, ... The question of priority of invention shall be determined by a board of patent interferences (consisting of three examiners of interferences) whose decision, if adverse to the claim of an applicant, shall constitute the final refusal by the Patent Office of the claims involved, and the Commissioner may issue a patent to the applicant who is adjuged the prior inventor. A final judgment adverse to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims involved from the patent, and notice thereof shall be endorsed on copies of the patent thereafter distributed by the Patent Office. . . .

* * * * * * * * * *

§ 141. Appeal to Court of Customs and Patent Appeals

. . . . A party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority may appeal to the United States Court of Customs and Patent Appeals, but such appeal shall be dismissed if any adverse party to such interference, within twenty days after the appellant has filed notice of appeal according to section 142 of this title, files notice with the Commissioner that he elects to have all further proceedings conducted as provided in section 146 of this title. Thereupon the appellant shall have thirty days thereafter within which to file a civil action under section 146, in default of which the decision appealed from shall govern the further proceedings in the case.

§ 142. Notice of appeal

When an appeal is taken to the United States Court of Customs and Patent Appeals, the appellant shall give

notice thereof to the Commissioner, and shall file in the Patent Office his reasons of appeal, specifically set forth in writing, within such time after the date of the decision appealed from, not less than sixty days, as the Commissioner appoints.

§ 143. Proceedings on appeal

The United States Court of Customs and Patent Appeals shall before hearing such appeal, give notice of the time and place of the hearing to the Commissioner and the parties thereto. The Commissioner shall transmit to the court certified copies of all the necessary original papers and evidence in the case specified by the appellant and any additional papers and evidence specified by the appellee and in an ex parte case the Commissioner shall furnish the court with the grounds of the decision of the Patent Office, in writing, touching all the points involved by the reasons of appeal.

§ 144. Decision on appeal

The United States Court of Customs and Patent Appeals, on petition, shall hear and determine such appeal on the evidence produced before the Patent Office, and the decision shall be confined to the points set forth in the reasons of appeal. Upon its determination the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office and govern the further proceedings in the case.

* * * * * * * * * *

§ 146. Civil action in case of interference

Any party to an interference dissatified with the decision of the board of patent interferences on the question of priority, may have remedy by civil action, if commenced within such time after such decision, not less than

sixty days, as the Commissioner appoints or as provided in section 141 of this title, unless he has appealed to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided. In such suits the record in the Patent Office shall be admitted on motion of either party upon the terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court imposes, without prejudice to the right of the parties to take further testimony. The testimony and exhibits of the record in the Patent Office when admitted shall have the same effect as if originally taken and produced in the suit. . . .

. . . Judgment of the court in favor of the right of an applicant to a patent shall authorize the Commissioner to issue such patent on the filing in the Patent Office of a certified copy of the judgment and on compliance with the requirements of law.

APPENDIX B

THE OPINION OF THE CCPA

UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

HERBERT H. SILVESTRI AND DAVID A. JOHNSON *Appellants,*

v.

NORMAN H. GRANT AND HARVEY E. ALBURN, *Appellees.*

Patent Appeal No. 8978.

Interference No. 94,856.

Decided: May 9, 1974

RICH, Judge.

This appeal is from the decision of the Patent Office Board of Patent Interferences awarding priority to appellee, the senior party, Grant et al. (hereinafter Grant). We reverse.

The sole count corresponds to claim 1 of Grant's patent,[1] on which he is involved in this interference. Appellants, Silvestri et al. (hereinafter Silvestri), provoked this interference by filing an application [2] after the issuance of the Grant patent, alleged to be a continuation-in-part of an earlier application.[3]

Silvestri took testimony and introduced documentary evidence to prove conception of the invention and its actual reduction to practice prior to Grant's filing date. Grant also took testimony and introduced exhibits. This was done, however, to rebut Silvestri's evidence rather than to prove a date of invention earlier than Grant's filing date.

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[1] Patent 3,144,445, issued August 11, 1964, on an application, serial No. 247,394, filed December 26, 1962, assigned to American Home Products Corporation.

[2] Serial No. 408,191, filed November 2, 1964.

[3] Serial No. 233,943, filed October 29, 1962, now U. S. Patent 3,180,862, issued April 27, 1965, assigned to Bristol-Myers Co.

Accordingly, Grant is restricted to his December 26, 1962, filing date as his date of invention and that is the date Silvestri must overcome.

The count reads:

> A new crystalline form of D-6-(2-amino-2-phenyl-acetamido) penicillanic acid characterized by being substantially free of water in the chemically bound state, having a molecular weight of about 349, having an infrared spectrograph as disclosed in Fig. 1 of the drawings, and possessing substantially greater storage stability than hydrated crystalline D-6-(2-amino-2-phenyl-acetamido) penicillanic acid.

D-6-(2-amino-2-phenyl-acetamido) penicillanic acid is an antiobiotic generically known as "ampicillin." Both parties agree that a form of ampicillin was known to the prior art. However, it contained from 2.5 to 10% by weight of water, lacked storage stability, and the process by which it was obtained was too expensive to be commercially feasible. The count distinguishes from that prior art form of ampicillin.

In the Grant patent, the prior art form of ampicillin is referred to as "ampicillin A" whereas the form defined by the count is designated "ampicillin B." Silvestri's application uses the terms "Form I" and "Form II," respectively, to designate the same forms of ampicillin.

The board held Silvestri was not entitled to rely on his earlier-filed application as a constructive reduction to practice because it did not disclose the subject matter of the count [4] and also held he had not sustained his burden of

[4] Silvestri's Notice of Appeal alleges that the board erred on this point. However, we deem that this allegation was abandoned as a basis for reversing the board since it was not discussed in the main brief. In the reply brief it is stated that "the sole reason Appellants are not pressing their reliance upon the disclosure of their earlier application is in order to simplify the issues involved in this appeal."

proving beyond a reasonable doubt[5] either conception or actual reduction to practice of the invention prior to Grant's filing date.

The Decision of the Board

The board held that Silvestri had not conceived or actually reduced the invention to practice before Grant's filing date and its opinion suggests that the ampicillin of the count had not been prepared prior to December 26, 1962, in the laboratories of Bristol Myers Co. (Bristol), the assignee of the Silvestri application. However, even more important to its decision was the board's conclusion that at the time the invention was alleged to have been made by Silvestri, there was no contemporaneous recognition that the new form of ampicillin defined by the count had been made. In this regard, the board made the following observations:

> * * * we have examined the entire testimony taken on behalf of Silvestri * * * and fail to find any evidence or [sic, of?] recognition or conception of the invention of the count *prior* to December 26, 1962, the record date of Grant. * * *
>
> * * * *
>
> * * * since Silvestri had no conception of the invention of the count prior to Grant's record date, on this ground alone, Silvestri cannot prevail in this proceeding and we so hold.

The board was obviously motivated to some extent to reach this conclusion because of the nature of the circumstances which led to the preparation and filing of the Silvestri application. It appears that Mr. Brink, counsel

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[5] This is the burden of proof which must be met by Silvestri, whose earliest application *disclosing* the invention was filed after the issuance to Grant of a patent claiming the invention. *Paivinen* v. *Sands*, 55 CCPA 1502, 399 F.2d 697, 158 USPQ 602 (1968) and *Paivinen* v. *Sands*, 52 CCPA 906, 339 F.2d 217, 144 USPQ 1 (1964).

who prepared the Silvestri application, became aware of the Grant patent shortly after its issuance and began an investigation to determine whether the compound of the count had been prepared at Bristol. In response to interrogatories, Brink made the following statement, quoted in the board opinion, regarding his investigation:

> The investigation included discussing with David A. Johnson the subject matter of the invention claimed in U. S. Patent No. 3,144,445 and determining from him that anhydrous α-aminobenzylpenicillin possessing considerably greater storage stability than previously known hydrated α-aminobenzylpenicillin had been prepared early in 1962 by a process which he and Herbert H. Silvestri had invented, which process is described in U. S. Patent No. 3,180,862. I obtained, either from Dr. Johnson or someone else in the pilot plant, the run data for making * * * anhydrous D-(-)-α-aminobenzylpenicillin. I then obtained the infrared curve for this lot from someone in the Control Group and stability data for this lot from someone in the Product Development Group. Mr. Joseph Bomstein examined the infrared tracing for [this] lot * * * and compared it to the infrared tracing contained in Figure 1 of U. S. Patent 3,144,445 and confirmed the fact that they were substantially identical.

In view of these circumstances the board drew the following negative inference relative to appellant's recognition of the invention:

> In conclusion, although not necessarily dispositive of the issues before us, in our opinion, it seems that the appearance of the involved Grant patent on the scene was the spur that led to or catalyzed the filing of the involved Silvestri application.

Also before the board was the question of whether Silvestri abandoned, suppressed or concealed the invention within the meaning of 35 USC 102(g). However, in view of its determination that Silvestri had not reduced the invention to practice, the board did not reach that issue.

OPINION

The ampicillin of the count is a new form of an otherwise old composition. It is now well settled that in such a case there is no conception or reduction to practice where there has been no recognition or appreciation of the existence of the new form. *Heard* v. *Burton*, 51 CCPA 1502, 333 F.2d 239, 142 USPQ 97 (1964); and *Langer* v. *Kaufmann*, 59 CCPA 1261, 465 F.2d 915, 175 USPQ 172 (1972).

The evidence in both of the above cases established that the appellants had actually obtained the novel subject matter[6] at a date earlier than the dates of invention accorded their opponents. However, in each instance the evidence also established that this success was not recognized until a later date. Absent a contemporaneous recognition that the new form had been obtained, and, in *Heard*, absent a recognition that it had been used in the claimed process, we held that there had not been conception or reduction to practice.

The rule applied in *Heard* and *Langer* is consistent with the principle of patent law that an accidental and unappreciated duplication of an invention does not defeat the patent right of one who, though later in time, was the first to recognize that which constitutes the inventive subject matter. See *Eibel Process Co.* v. *Minnesota and Ontario Paper Co.*, 261 U.S. 45, 66 (1923). In the context of *Heard* and *Langer*, therefore, until they recognized their accomplishment, the preparation of the new form by each of the appellants remained in the accidental and unappreciated category. A fortiori, no right to a patent arose prior to such recognition.

The effect of these cases is that an inventor of a new form of an old composition cannot be accorded a date of

[6] In *Heard*, the count defined a process using a novel form of alumina. In *Langer*, the count was directed to a novel form of a titanium chloride-aluminum chloride complex.

invention earlier than the date when he recognizes the existence of the new form. Accordingly, the principal issue before us now is whether the evidence establishes beyond a reasonable doubt that, prior to Grant's filing date, Silvestri not only actually prepared Form II, but also appreciated that a new form of ampicillin had been obtained. We think it does.

The record establishes that a great deal of work was done in the pilot plant at Bristol on an improved procedure for making "P50", the code name at Bristol for any and all forms of ampicillin.[7] This procedure is summarized in a memorandum, Silvestri Exhibit (SE) 5, dated April 2, 1962, that was prepared by Dr. David A. Johnson, named as a coinventor with Silvestri, who was head of the Chemical Development Laboratories at Bristol. SE 5 itself contains no reference to a product differing from the ampicillin previously prepared at Bristol. However, Johnson testified on cross-examination that he and Silvestri came to realize that a different form of ampicillin could be obtained by this process from the results of, among other things, infrared analysis and water assays. When pressed regarding when this awareness arose, he testified that he though it was in April of 1962.

It was the practice at Bristol to assign code numbers to the lots of ampicillin prepared. The code uses the designation "12 CD" followed by a number specific to each individual lot. For each lot a standard form was prepared, known as a "dog eared card," on which the results of a variety of analytical determinations made on the sample were recorded. Among the analyses performed were infrared, water assays, and storage stability tests. There were, in fact, two storage stability tests. One of

[7] The record establishes that in addition to Forms I and II at least two other forms of ampicillin are known. Both of these are the subject of patents assigned to Bristol. One of these is a trihydrate. The other is yet another anhydrous form free of bound water.

these was a chemical test known as an "iodometric assay," the other was a biological test which involved subjecting the bacterium *Staph. aureus* to the ampicillin to determine if it was killed. Both tests were standard methods used by the pharmaceutical industry to determine the stability of penicillin and related antibiotics. Ampicillin is a penicillin-type antibiotic.

The Record Establishes that Form II Ampicillin Was Prepared at Bristol Prior to December 26, 1962

Of particular interest on the question whether Form II ampicillin was actually made at Bristol are pilot plant lots 12 CD 57, 12 CD 61, 12 CD 71, 12 CD 82, 12 CD 100, 12 CD 106, 12 CD 107, and 12 CD 131 (also designated K 2035[8]).

Between April 4, 1962, and September 24, 1962, these lots were analyzed for their water content. The results ranged from 0.3% water, in the case of 12 CD 100, to 1.8%, for 12 CD 82, as determined by what is referred to as the "Karl Fischer" method. Although this method is a standard analytical technique, it cannot distinguish between chemically bound water, a property exhibited by hydrates, and water present as an impurity. Nevertheless, whether this water is bound or not, samples which exhibit from 0.3% to 1.8% of water are "substantially free of water in the chemically bound state," as called for by the count.[9]

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[8] The "CD" numbers are assigned for purposes of the Chemical Development Laboratory. K 2035 is the "Bristol Control Number" for Lot 12 CD 131, which was given this number as it was intended that it be used as a standard against which other lots of ampicillin were to be compared.

[9] The Grant patent contains the following statement:

> This new compound [referring to ampicillin B] is characterized by the fact that it has very little, if any, water, up to no more than 2.5%.

The upper limit stated in the Silvestri application and found in the analysis of the pilot plant lots is 1.8%.

These same lots were also subjected to infrared analyses before December 26, 1962. The spectrographs obtained were examined by Bristol's expert in infrared spectroscopy, Joseph Bomstein. Testifying as an expert, he stated that the spectrograph of each lot was essentially the same as that of Figure 1 of the Silvestri application. It is pertinent to note here that no challenge has been made to the substantial identity of this spectrograph with that of Figure 1 of the Grant patent.

No challenge has been made regarding Bomstein's qualification as an expert and no rebuttal to his testimony was offered by Grant. We note that the board was critical of Bomstein's testimony on the ground that it came after the issuance of Grant's patent. That criticism would, of course, be relevant if the testimony were relied upon to show that Silvestri had appreciated in 1962 that a new form of ampicillin had been made. However, Bomstein's testimony is used only to establish that Silvestri had *obtained* the new form of ampicillin before December 26, 1962. Accordingly, we accept this testimony as establishing that the ampicillin obtained by Silvestri and that of the count have the same spectrograph.

We believe that the results of the water assays and infrared analyses establish beyond a reasonable doubt that Silvestri had actually prepared a form of ampicillin corresponding to that obtained by Grant and thus to the count. In reaching this conclusion, we do not disregard the fact that the count also requires that the ampicillin possesses greater storage-stability than hydrated ampicillin [10] and have a molecular weight of about 349. However, we regard these as inherent properties of Form II ampicillin which add nothing to the count definition beyond that determined by the water content and infrared spectograph. In our view, these latter properties are sufficient

[10] There is evidence in the record which establishes that the lots in question were storage stable.

to fully identify the new form of ampicillin. See footnote 8 of *In re Ruschig*, 52 CCPA 1238, 343 F.2d 965, 145 USPQ 274 (1965).

The Record Establishes That Silvestri Recognized and Appreciated That a New Form of Ampicillin Had Been Obtained

Although we have concluded that Silvestri had actually prepared Form II ampicillin before December 26, 1962, there still remains the question whether, before that date, he recognized and appreciated that a new form of ampicillin had been obtained.

In *Heard* v. *Burton*, supra, the count involved was directed to a process which required "a catalyst comprising platinum on eta alumina." Prior to the date of invention alleged by Heard, the existence of eta alumina had not been reported in the prior art although the evidence established that Heard's research had resulted in the preparation of eta alumina. Nevertheless, the court denied Heard his alleged date of invention. We said:

> We agree with appellant that it is irrelevant that Heard never referred to or appreciated the support material to be *eta*-alumina or to contain *eta*-alumina *by that name*. Nor do we interpret the board's opinion as so requiring. However, we consider it fatal to appellant's case that not until after appellees' filing date did Heard recognize that his "ammonia-aged" catalyst, as appellees put it, "*contained any different form of alumina at all!*"
>
> We point out, as does appellees' brief, that the count calls for a *particular* form of alumina and we think that appellant's failure to recognize that he had produced a new form, regardless of what he called it, is indicative that he never conceived the invention prior to appellees' filing date.

The quoted passage sets forth the standard by which we evaluate Silvestri's evidence. This standard does not

require that Silvestri establish that he recognized the invention in the same *terms* as those recited in the count. The invention is not the *language* of the count but the subject matter thereby defined. Silvestri must establish that he recognized and appreciated *as a new form*, a compound corresponding to the compound defined by the count.

As pointed out above, his coinventor Johnson testified that he and Silvestri became aware that a new form of ampicillin was produced from the results of infrared analyses and water assays done on samples made according to the procedure set forth in SE 5. He thought this awareness came in April of 1962. We now look to the record for confirmation of this fact.

The evidence shows that ampicillin (or P50) was being manufactured at Bristol and that routine analyses, including infrared and water assays, were obtained from lots prepared in the pilot plant. All the infared spectographs for the lots of ampicillin previously enumerated, except 12 CD 106 and 12 CD 107, were obtained by a single employee, David A. Hull, at Bristol. With respect to the spectograph for lot 12 CD 57, on April 7, 1962, he made entries in the infrared master log (SE 36) and his own notebook (SE 37). The notation in the master log reads:

> 12 CD 57 (P50) different xyl [crystal] form.

The notation in the notebook reads:

> 12 CD 57 (P50) conforms, 2nd crystalline form, bands much sharper than normal P50.

He testified that these notations represent conclusions drawn from comparison of the spectrograph of 12 CD 57 and that of the standard.

The dog-eared card for lot 12 CD 71 (SE 33) bears the following entry relative to the infrared spectrograph:

> By I.R. [infrared] this sample looks different crystallographically from most other P50's. (A) Second Polymorph? (B) More Amorphous?"

This entry was in the handwriting of John P. Messerly, Director of Quality Control at Bristol. He testified that the entry was based on conclusions reached by Bomstein. Bomstein confirmed this. It was thought that these entries were made on April 22, 1962, and the record establishes that they could not have been made later than May 29, 1962.

The infrared spectrographs for lots 12 CD 106 and 12 CD 107 were obtained by Mr. Ithamar E. Pollak. Mr. Pollak worked under Mr. Bomstein during the period when the invention was alleged to have been made. His notebook, SE 40, contains the following entry, dated July 5, 1962, relative to these lots:

> All confirm Form two of P50.

Pollak also entered the notation "Form II" on the corresponding dog-eared cards. His explanation of the meaning of these entries was that Bomstein had told him that there were two forms of ampicillin and had given him samples of lots 12 CD 106 and 12 CD 107 for a determination of which form they were. He further testified that he made the identification entered in his notebook by comparing their spectographs.

At about the same time these infrared spectographs were being studied, stability tests were being run on the pilot plant lots. The results of these tests were such that Mr. Frank H. Buckwalter, Director of Product Development at Bristol, was moved to send a memorandum (SE 6) to Johnson in which he pointed out that lots of ampicillin which were essentially anhydrous, including lots 12 CD 57 and 12 CD 71, have good stability.

This evidence confirms Johnson's testimony that prior to December 26, 1962, it was realized that a new form of anhydrous ampicillin having improved stability had been obtained. Any weakness in the evidence, as discussed to this point, that might suggest a reasonable doubt is removed by the fact that on November 5 ,1962, Bristol sought

promulgation of regulations for a new form of ampicillin from the Food and Drug Administration (FDA) in order that they might market it. Included with the request (SE 47) was a product specification (SE 46) setting forth a description of the new drug which corresponds to that of the lots which we have held correspond to subject matter defined by the count. Certificates of analyses of individual lots of this new form were also included with the request. One of these (SE 44) is for lot K 2035, one of the lots enumerated above, which is an actual lot of Form H ampicillin .

The board's opinion is critical of the testimony of those who obtained the infrared spectrographs for the reason that they could not say of their own knowledge what the reference spectographs were. But this is not a fatal weakness in appellant's case. As we have already stressed, the critical question is whether there was contemporaneous recognition and appreciation of the new form of ampicillin. The testimony of these persons establishes that there was recognition and appreciation, even though identification of a given lot of ampicillin as Form I or Form H could not be made from an infrared spectrograph without resort to comparison with a standard.

The board also criticized appellants' water assays for the reason that they imply no recognition that the lots were "substantially free of water in the chemically bound state," as called for by the count. However, the language of the count is but one way to define the new form and certainly not a unique definition. Our opinion in *Heard v. Burton, supra*, makes it clear that the recognition and appreciation of a new form need not be in the same terms as the count. In our view, appellants have established that they were able to recognize the new form by its infrared spectograph and lower water content. Any claim they might have written, based on this or other information specific to Form H, would still define the same subject matter as the count even though in different terms.

Appellee Grant criticizes the evidence related to the request for certification made to the FDA on the ground that the testimony of Dr .Harold A. Frediani, the official requesting the certification, indicates that Bristol was actually trying to have certified a trihydrate form of ampicillin. This is not an accurate characterization of that testimony. In fact, Dr. Frediani testified that they sought to have the anhydrous form certified, but later amended the certification request to specify the trihydrate for the reason that, as he recalled, "a [another] new form was developed in our laboratory in the production area, which was the trihydrate, and a comparison of the two [Form II and the trihydrate] indicated there was a certain advantage to the trihydrate over the anhydrous."

The Record Establishes That The New Form Had Utility

Before the board, Silvestri argued that no testing of the new form to show utility would be required because utility would be obvious. In the alternative, it was argued that the tests done to determine stability which involved subjecting the bacterium *Staph. aureus* to the ampicillin proved utility.

With regard to the first argument by Silvestri, the board commented:

> The count in the instant case is directed to a new compound. We note, in spite of the fact that Silvestri urges in the brief that the utility of the purported compound was obvious, several lots were tested at Bristol against Staphylococcus aureus. We find no evidence in the Silvestri record to indicate that these tests were unnecessary.

We disagree with the board's position on several points and conclude that utility would have been obvious. In the first place, Form II is not a new compound but a new form of an old one, i.e., ampicillin. There is no reason to believe

that the crystal structure and absence or presence of bound water would affect the pharmacological properties of ampicillin. Furthermore, the tests in question were run to demonstrate shelf stability of specific lots. Nevertheless utility can be inferred from these tests because a harmful bacterium was killed even though the tests were not run for that purpose.

The board also concluded that the stability tests did not establish utility for the reason that:

> Of course, even if the tests were a success, as we have seen supra, the product tested therein was not established to be the product of the count, but rather P 50.

The error in this conclusion by the board is apparent from our opinion, as it is our view that the product tested was the product of the count. Accordingly, we must regard these tests as actually establishing that Form II has a utility, even were we to agree that its utility was not obvious.

Silvestri Did Not Abandon, Suppress, Or Conceal the Invention

Since we are satisfied that Silvestri has proven beyond a reasonable doubt an actual reduction to practice of the invention no later than November 5, 1962, the date of the request to the FDA, we must now address the question whether that invention was abandoned, suppressed, or concealed within the meaning of 35 USC 102(g). We have noted above that the board did not reach this issue. Although we would find it useful to have the board's views on this point, we do not feel this is one of those cases in which a remand to the board is necessary. Cf. *Myers* v. *Feigelman*, 59 CCPA 834, 455 F.2d 596, 172 USPQ 580 (1972) and *Langer* v. *Kaufman*, *supra*.

We do not doubt that Silvestri was moved to file the application by knowledge of the Grant patent. However,

this fact alone is not sufficient to establish abandonment, suppression, or concealment of the invention. See *Brokaw* v. *Vogel*, 57 CCPA 1296, 429 F.2d 476 ,166 USPQ 428 (1970).

Although Grant alleges generally that the invention was abandoned, suppressed, or concealed by Silvestri, his argument is in fact an attempt to demonstrate abandonment. Without more evidence to the contrary, the fact that Silvestri sought FDA registration of the new form, even though the request was later amended, shows there was no attempt to suppress or conceal the invention. The principal reliance by Grant is on Silvestri's delay in filing and the fact that his application was made as a result of the issuance of the Grant patent. Although these facts in certain contexts might be some evidence of abandonment they are not enough in themselves to establish a prima facie case.

Furthermore, the record shows that stability tests were being run on lots of Form II until at least 1966. While tests done after the issuance of the Grant patent might be said to have been done merely to preserve the appearance of non-abandonment, SE 43, a record of stability tests, shows that a biological assay was done on lot 12 CD 61 on April 21, 1964, and the same test was performed on lot 12 CD 100 on July 10, 1964, just one month prior to the issuance of the Grant patent. This activity is certainly evidence of continued interest in Form II ampicillin at Bristol and clearly negatives abandonment.

The burden of proving abandonment, suppression, or concealment is on the party alleging it. *Gallagher* v. *Smith*, 41 CCPA 734, 206 F.2d 939, 99 USPQ 132 (1953). In our view the evidence is not sufficient to sustain appellee's burden on that contention.

For the foregoing reasons, the decision of the board is *reversed*.

REVERSED

MILLER, JUDGE, *concurring.*

The decisive question in this case is whether appellants have sustained their burden of proving beyond a reasonable doubt that before December 26, 1962, they *recognized* that they had obtained Form II ampicillin. That they had actually obtained it, as the majority finds, is amply supported by the record, including Bomstein's unrebutted testimony that the spectrograph of each of various lots, particularly K2035, was the same as Figure 1 of appellants' application.

Appellees have attached great significance to the Rule 131 affidavit (included in the file wrapper of the Form III patent, 3,472,841, assigned to Bristol-Myers) asserting actual reduction to practice of Form III ampicillin prior to December 26, 1962. The affidavit is significant, as appellees point out, in showing that the contemporary, recorded statements of Hull, Messerly, and Pollak, and the testimony of Dr. Johnson are ambiguous in that these distinguish a form of ampicillin from Form I, but do not differentiate between Form II and Form III. However, the affidavit is also significant in that the accompanying spectrograph for lot 12CD149 contains a notation "Form III." The date "11/23/62" in the "CD Book" (appellants' exhibit 24) is that on which the number 12CD149 was assigned. Thus, on or after November 23, 1962, but prior to the critical date of December 26, 1962, there was recognition of Form III. If there were recognition of Form III, there had to be recognition of Form II.

APPENDIX C

OPINION AND DECISION OF BOARD OF PATENT INTERFERENCES JANUARY 15, 1971.

Gaston, Modance and Milestone, Examiners of Interferences

Modance, Examiner of Interferences

The subject matter of this interference is defined by the sole count as follows:

Count 1

> A new crystalline form of D-6-(2-amino-2-phenyl-acetamido)penicillanic acid characterized by being substantially free of water in the chemically bound state, having a molecular weight of about 349, having an infrared spectrograph as disclosed in Fig. 1 of the drawings, and possessing substantially greater storage stability than hydrated crystalline D-6-(2-amino-2-phenyl-acetamido) penicillanic acid.

The involved Silvestri et al. (Silvestri) application is assigned to Bristol-Myers Co. (Bristol) and the Grant patent is assigned to American Home Products Corporation.

Both parties took testimony; Grant did not take testimony relative to their own priority proofs. Both Silvestri and Grant submitted exhibits and cross-exhibits. The Silvestri record will be referred to as SR- the exhibits as SE and the cross exhibits as SCE; the Grant record will be referred to as GR-, with rebuttal testimony as GRR-, the exhibits as GE and the cross exhibits as GCE. Both parties filed briefs and were represented by counsel at final hearing. By leave of the Board of Patent Interferences, memoranda of law were filed by the parties after final hearing.

The Invention in Issue

By way of background, it is noted that the basic patent (not involved in the instant interference) covering α-aminobenzylpenicillins, also known as 6-(2 amino-2-phenyl-acetamido) penicillanic acids, was issued on May 23 ,1961 to Doyle et al. (SE-1). This patent discloses and claims α-aminobenzylpenicillin broadly, see claim 2 thereof and col. 3, lines 16 to 18, referring to the D- and L- forms while claim 5 recites the D-form specifically. The D-form is also shown in Example 7 as the monohydrate while the L-form is shown in Example 8 as the pure anhydrous variety.

The sole count in issue, corresponding exactly to claim 1 of the involved Grant patent, defines a *new crystalline form* of D-6-(2-amino-2-phenyl acetamido) penicillanic acid, which is also known as D-α-aminobenzylpenicillin.

The Issues

There are three major issues involving the determination of priority in this interference, namely:

1. Is Silvestri entitled to the benefit of the October 29, 1962, filing date of the parent Silvestri application S. N. 233,943, now U. S. Patent 3,180,862 for constructive reduction to practice of the invention of the count?

2. Does the Silvestri record establish an actual reduction to practice prior to December 26, 1962, the filing date of the application which matured into the involved Grant patent?

3. In the event issue 2, supra, is resolved in favor of Silvestri, does the record before us establish that Silvestri abandoned, suppressed or concealed the invention and was spurred into activity only upon seeing the Grant patent issue in August, 1964?

The Grant Request for Appropriate Action Leading To Dissolution of the Interference

On page 3 of their brief, Grant requests the Board of Patent Interferences to take appropriate action (including, if necessary, a suitable recommendation under Rule 259) leading to a dissolution of the interference, based upon 35 USC 102(b) because of the issuance on July 20, 1963 of Grant's corresponding Iraqi Patent No. 192 (GE-40). The file history of the instant interference shows that said interference was initially dissolved by a Primary Examiner on March 28, 1966 because of Grant's Iraqi patent No. 192. However, on August 5, 1969, by Paper No. 27, the interference was reinstated by another Primary Examiner "because the reference which was held to be prior art against one of the parties (Silvestri et al.) has been shown to have an ineffective date . . . ."

Pursuant to Paper No. 27, the Patent Interference Examiner issued an order, on August 5, 1969 officially reinstating the interference. Grant tried twice unsuccessfully by petitions to the Commissioner to vacate the reinstatement of the interference. See Commissioner's Decisions of November 26, 1969 and December 30, 1969, Papers No. 43 and 47.

Adverting to the Grant request, it is well settled that the making of recommendations under Rule 259 is a matter wholly within the discretion of the Board of Patent Interferences, Wert v. Borst et al., 1906 CD 198, 122 O.G. 2062.

We have carefully considered the entire record relative to the Iraqi patent and the arguments in the briefs before us directed thereto and conclude that we find no clear basis for recommending any action under Rule 259. Accordingly, the Grant request for appropriate action leading to dissolution of the interference is *denied*.

The Parent Silvestri Application

In a decision on motions, March 28, 1966, Paper No. 23, the Primary Examiner denied the Silvestri motion to shift burden of proof on the ground that the disclosure in the parent Silvestri application S. N. 233,943, filed October 29, now Patent No. 3,180,862, relative to the invention represented by the count in issue, does not satisfy the requirements of 35 USC 120.

The pertinent portion of 35 USC 120 reads as follows:

§ 120. Benefit of earlier filing date in the United States

> An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States by the same inventor shall have the same effect, as to such invention, as though filed on the date of the prior application,
>
> * * * * * * *

The first paragraph of "section 112", supra, reads as follows:

§ 112. Specification

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such *full, clear, concise, and exact terms* as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention. (our emphasis added)

We will not concern ourselves with the "best mode" requirement, supra, since this matter is not ancillary to priority and hence is not before us. Thompson v. Dunn et al., 35 CCPA 957, 166 F2d 443, 77 USPQ 49, 53.

It is well settled that one who abstracts claims from an issued patent must show a clear prior disclosure. That requirement is the same where one relies on an earlier

application for support in order to obtain the benefit of its filing date as where support in an application directly involved in the application is in issue. Kilby v. Noyce, 57 CCPA —, 163 USPQ 550.

All limitations in a (patent) claim constituting a count in interference are considered material in determining the question of right to make and doubts arising as to such right must be resolved against the copier.

The Primary Examiner in a pertinent portion of page 4 of the decision on motions, clearly stated, as to the parent application:

* * * *

> Briefly, the count is directed to a D-isomer. Example 2 certainly identifies no isomeric form. The product may have been the L-form or a racemic mixture thereof. The specification of '943 is silent as to the identity of the optical isomer. Moreover there is no hint that the product is anhydrous. It could well be the monohydrate. To find the compound corresponding to the count requires pure speculation.

* * * *

We agree with the Primary Examiner's conclusion that the parent Silvestri application, Patent No. 3,180,862, does not disclose the subject matter of the count.

The Matter of Inherency

The involved Silvestri application which we will refer to as Silvestri II contains much new matter as compared with parent SE 2, *especially the recognition of a new crystalline form* in paragraph 2, page 1 of Silvestri II. While the process steps in Examples 1 and 2 of SE 2 are identical with the process steps in Example 1 of Silvestri II, the following additional matter appears at the end of Example 1 of Silvestri II:

> This crystalline product is designated Form II D-(-)-α-aminobenzylpenicillin, and is characterized by

being substantially free of water in the chemically bound state, having a molecular weight of about 349, having an infrared absorption spectrum substantially as disclosed in Fig. 1 of the drawings, and possessing greater storage stability than Form I D-(-)-α-aminobenzylpenicillin.

In addition, Example 2 appears in Silvestri II and this admittedly has no counterpart in SE 2.

Silvestri urges on pages 36 to 38, inclusive, of the main brief that all the physical properties recited in the count are inherent characteristics of the compound and specific recitation of these properties in the parent application is not necessary for a disclosure of the compound defined by the count, especially since the processes in Examples 1 and 2 of SE 2 when combined equal the processes in Example I of Silvestri II. Moreover, Silvestri contends that Example 13 of SE-2 also inherently discloses a process which results in compounds as defined by the count in interference. Where support must be based on an inherent disclosure, it is not sufficient that a person following the disclosure might obtain the result set forth in the count; it must invariably happen. Smith v. Wehn, 50 CCPA 1544, 318 F2d 325, 138 USPQ 52; Dreyfus et al. v. Sternau, 53 CCPA 1050, 357 F2d 411, 149 USPQ 63.

With regard to Example 13 of SE-2, Silvestri maintains, page 36 of the brief, that Dr. Johnson, a co-inventor of Silvestri, testified that the product obtained by this example was crystalline, anhydrous D-α aminobenzyl penicillin since it was made by the method described in his memorandum of April 2, 1962 (SE 5, SR 35, 36). Further Silvestri urges that the fact that it is not stated in Example 13 whether the product is anhydrous or a hydrate is indicative of the fact that it is anhydrous since a material which is not designated as being a hydrate is generally considered to be anhydrous (SR 37).

First, we decline to treat the testimony of Johnson offered for the purpose of explaining the disclosure of

SE-2 relative to Example 13. Fishburn v. Vincent, 24 CCPA 1079, 88 F2d 711, 33 USPQ 156 citing Cooper v. Downing 1916 CD 3, 4. However, with regard to inherency, testimony is admissible but we note that Johnson did not testify in fact that the product of Example 13 was made by the method described in SE 5 but rather that in answer to XQ 39, SR 36, Johnson stated:

> From the method by which it was prepared outlined in Section C of my memorandum of April 2d, * * * * (our emphasis added)

SE 5 refers to steps A, B and C of a method beginning with:

A. Acylation of 6APA (6-aminopenicillanic acid with Phenylglycyl Chloride HCl (P 50-17)

B. Isolation of P-50 as the β-Naphthalenesulfonate Salt (P50NSA)

C. Recovery of Crystalline P 50 From P50. NSA

Significantly, the parent application, SE-2 contains no disclosure of acylation of 6APA with any form of phenylglycyl chloride HCl, so that in any event no correlation has been established between SE 2 and SE 5, so as to establish inherent production of the product of the count.

Silvestri relies on In re Nathan, 51 CCPA 1059, 328 F2d 1005, 140 USPQ 601 and Petisi et al. v. Rennhard et al., 53 CCPA 1452, 363 F2d 903, 150 USPQ 669.

The Nathan case does not involve a claim copied from a patent and is not therefore, in our opinion, necessarily dispositive of the issue before us. However, the decision therein would appear to support Grant, not Silvestri. Example 1 in the Nathan specification which was illustrative of the products of the present invention, according to the Court, page 411 of the CCPA reports, "gave a definite melting point range, optical rotation, ultraviolet spectral

analysis and chemical analysis for the product obtained therein." The Court further stated,

> Appellants have further shown through an affidavit that the hydrolysis of the product of their Example 1 of their application yields a 2-fluoro hydrocortisone which has physical constants consistent with a product designated in the art as a 2 α-fluoro hydrocortisone. Such evidence, we think is adequate to demonstrate an inherent characteristic (the alpha orientation) of appellants' claimed subject matter.
>
> Thus, we consider that the amendatory material of June 15, 1959 is concerned with an inherent characteristic of an illustrative product of appellant's invention *already sufficiently identified* in appellant's original disclosure as filed. Such amendment is not prohibited by statute. (our emphasis added).

In contrast, no comparable analytical [data] is found in SE 2; we do not find the invention of the count sufficiently identified or recognized in the parent Silvestri case, SE-2, so as to enable us to conclude that Silvestri had a constructive reduction to practice when the parent Silvestri application was filed on October 29, 1962. Nor can we conclude on the record before us, that any process disclosed in the parent specification will inevitably produce the product of the count. Nor has Silvestri presented any argument in his brief or directed us to any corroborated testimony to support a conclusion that the product obtained by carrying out the processes of Examples 1 and 2 or Example 13 of SE 2 is *necessarily* the product of the count; Smith v. Wehn and Dreyfus v. Sternau, supra.

In our view, the Petisi v. Remmhard decision is inapposite with regard to the issue of inherency. The Court, without treating the issue of inherency, and paraphrasing certain statements in the parent Petisi application which was the crux of the issue, stated at page 1456 of the CCPA reports:

> [3] What we think appellants effectively said in their parent application is: "We are not absolutely

certain, but we think isomers (A) and (B) are the 7-nitro and 9-nitro-6-demethyl-6-deoxytetracyclines." This is not a shotgun announcement, or blind speculation, but direct to-the-point disclosure of what appellants believed, without alternatives. The mere fact of its being a belief is not, of itself, fatal to appellants' case. *The compounds were, we think, taught to one of ordinary skill in the chemical art.* (our emphasis added)

Actual Reduction To Practice

Inasmuch as we have held that the Silvestri parent application SE 2 does not disclose the subject matter of the count in issue and since the involved Silvestri application was filed subsequent to the issuance date of the involved Grant patent, Silvestri has the burden of establishing priority beyond a reasonable doubt. Paivinen v. Sands, 52 CCPA 906, 339 F2d 217, 144 USPQ 1.

In our opinion, the record for Silvestri does not establish an actual reduction to practice of the invention of the count beyond a reasonable doubt.

Johnson, the co-inventor, was head of the Chemical Development Laboratories at Bristol in 1962. He supervised process control or process development work. As admitted by Grant, a great deal of work was done at Bristol on a pilot plant scale in 1962, pursuant to a procedure outlined in memorandum, SE 5 already referred to supra; namely said procedure directed to acylation of 6APA with D-phenylglycyl chloride HCl. The product obtained by this acylation was referred to at Bristol as "P50" a designation used to include *all* forms of D-α aminobenzylpenicillin. (SR 11) We find no reference to nor recognition of the product of the count in SE 5. In fact we have examined the entire testimony taken on behalf of Silvestri, almost a thousand pages in all and fail to find any evidence or recognition or conception of the invention of the count *prior* to December 26, 1962, the record date of Grant. Nor

does Silvestri indicate in the briefs where this evidence may be found.

Johnson, testifying on rebuttal (GRR 89) stated that there was no separate invention record of application S. N. 408,191, the involved Silvestri application. As a matter of fact, the attorney who prepared the involved Silvestri application and filed same in the Patent Office, volunteered the information that the invention record for the parent Silvestri application (GCE 1) was to cover the product which is the subject matter of the interference (GRR 88, 89), the same parent application which, clearly, does not disclose the product of the count.

To summarize at this point, since Silvestri had no conception of the invention of the count prior to Grant's record date, on this ground alone, Silvestri cannot prevail in this proceeding and we so hold. Heard v. Burton et al., 51 CCPA 1502, 333 F2d 239, 142 USPQ 97.

Further, we note in answer to interrogatories by counsel for Grant, Brink, the attorney of record for Silvestri stated that he first made the factual determination that Silvestri and Johnson, the co-inventors had performed work, either themselves or others on their behalf, that allegedly constituted the invention claimed, soon after the involved Grant patent issued (page viii of the interrogatories). The investigation leading up to the factual determination was made by Brink several months prior to the filing date of the involved Grant patent (page x).

Finally, we find the following on page x of the interrogatories in answer to question 19:

> The investigation included discussing with David A. Johnson the subject matter of the invention claimed in U. S. Patent No. 3,144,445 and determining from him that anhydrous α-aminobenzylpenicillin possessing considerably greater storage stability than previously known hydrated α-aminobenzylpenicillin had been prepared early in 1962 by a process which he and

Herbert H. Silvestri had invented, which process is described in U. S. Patent No. 3,180,862. I obtained, either from Dr. Johnson or someone else in the pilot plant, the run data for making lot No. 12 CD 61 of anhydrous D-(-)-2-aminobenzylpenicillin. I then obtained the infrared curve for this lot from someone in the Control Group and stability data for this lot from someone in the Product Development Group. Mr. Joseph Bomstein examined the infrared tracing for lot 12 CD 61 and compared it to the infrared tracing contained in Figure 1 of U. S. Patent 3,144,445 and confirmed the fact that they were substantially identical.

Employing lot 12 CD 61 as being illustrative of the work done at Bristol at the pilot plant, we note that Johnson testified that 12 CD 61, having a moisture content of 1.1% "would probably be free of bound water" (SR 23). We find no corroboration of this testimony. Moreover, at the time 12 CD 61 was prepared in 1962, Marquette, project supervisor in the Chemical Development Pilot Plant, testifying on rebuttal (GRR 48) stated that it was not the custom in the analytical laboratory to give an indication of a distinction between chemically bound water and physically associated water. The term "being substantially free of water in the chemically bound state" is one of the limitations in the count, it is noted . Moreover, none of the tests for moisture at Bristol are either alleged or demonstrated to define between the compound of the count and still another compound claimed in a patent issued to Johnson et al October 14, 1969 and assigned to Bristol; namely Patent No. 3,472,841 (GCE 3) in which still another anhydrous crystalline form of D-2 aminobenzylpenicillin is claimed.

Adverting now to the infra red traces (the I.R.'s) offered on behalf of Silvestri as an alleged means of identification of the product of the count, from time to time, the Chemical Control Laboratory received samples of finished products along with accompanying dog-eared cards by messenger from the Control Office where the cards originated.

In the left hand most column on the card various required tests were listed. If a particular test was called for, the sample went first to the technician who ran the tests. After the test was run, the technician crossed off the test in his specialty and passed the sample and the card to another technician to run a second test called for on the card, etc. Opposite the test designated as "I.R. Curve" in SE 7 for sample 12 CD 61, we find the word under the column *Results*, "Conforms."

Marquette, the project supervisor testified as follows (SR 250, 251):

> XQ 43 Do you know what the typewritten and handwritten entries respectively of the word "conforms" opposite the typewritten entry, which is the fifth one in the far left column—"I.R.Curve"—do you know what the word "conforms" means?
>
> A This would mean that the Control people had a sample of P50 as we call it. The usual procedure is that this material would be recrystallized many times until they felt it was as pure a form as they could find—this is Control now—they would run an I.R. Curve on that and they would compare our material produced in the pilot plant with that curve and it would be up to the analyst or chemist to make a judgment if it does conform.
>
> XQ 44 Would that sometimes be called a Standard?
>
> A. Yes.
>
> XQ 45 Do I understand your testimony to be now that you are of the view the 12CD61 sample was found on the I.R. analysis to conform to the I.R. analysis of a previously available standard?
>
> A. Yes.
>
> XQ 46 Do you know what standard or control—to use shown in the second column of this card, which is Exhibit 7?
>
> A. No, I do not.

In addition Johnson's testimony sheds no light on the nature of the available standard and Johnson was a co-inventor.

Messerly, head of the Chemical Control Department stated (SR 586) that IR analyses were performed routinely by Hull and if there were need for interpretation of a particular IR curve, Messerly relied on a Dr. Bomstein, who was an analytical chemist in charge of all IR spectroscopy at Bristol (SR 586, 771).

Hull, supra, testified with regard to an IR standard that the latter represented the first compound sample of a particular lot that came into the laboratory. Then the second sample of the lot which came into the lab was compared with the standard (SR 758). Hull stated that he did not know the whereabouts of the spectrum for the standard. Furthermore, even at that, Hull only knew what the reference standard was after some one told him and that person was not identified by Hull (SR 763).

Bomstein, the IR expert, was asked in 1970 to compare IR curves of various lots such as 12CD57, 12CD61, 12CD63 with Figure 1 of the Silvestri application but the latter was filed *November 2, 1964* after the involved Grant patent issued. (SR 775, et seq.) Contemporaneous conclusions of Bomstein, i.e. in 1962, when the work was done, were based largely on speculation (SR 814). We note, further that we find no progress reports at Bristol directed to the invention of the count at the time the work purportedly resulting in the production of the compound of the count was completed in 1962. At least Johnson could not recall any (SR 85).

Without belaboring the issues any further, we find no evidence in the record of Silvestri to establish the preparation and identification of the compound of the count, the testing of said compound for utility nor corroboration of preparation, identification and utility testing prior to the record date of Grant.

With regard to utility, Silvestri has a two pronged argument. First, it is urged, testing is unnecessary, since the utility was obvious; secondly, if testing is necessary tests

were successfully carried out against Staphylococcus aureus with at least lot 12CD61.

Larson et al. v. Eichler, 9 USPQ 461, cited on page 21 of the Silvestri reply brief is inapposite since in that case, the cod liver oil extracts were old materials and the counts therein were directed to the method of making a combination of ingredients and a medicinal agent comprising same. The count in the instant case is directed to a new compound. We note, in spite of the fact that Silvestri urges in the brief that the utility of the purported compound was obvious, several lots were tested at Bristol against Staphylococcus aureus. We find no evidence in the Silvestri record to indicate that these tests were unnecessary. Cf. Blicke v. Treves, 44 CCPA 753, 241 F2d 718, 112 USPQ 472, particularly, [5], page 475 of the USPQ reports. Of course, even if the tests were a success, as we have seen supra, the product tested therein was not established to be the product of the count, but rather P 50.

In conclusion, although not necessarily dispositive of the issues before us, in our opinion, it seems that the appearance of the involved Grant patent on the scene was the spur that led to or catalyzed the filing of the involved Silvestri application.

To complete the record, the motion to suppress testimony (of Braun) filed April 30, 1970 by Silvestri and deferred to final hearing in the order of June 4, 1970, Paper No. 57 is deemed moot in view of our denial of request by Grant to recommend dissolution of the interference, supra.

Conclusions of Law

1. The record for Silvestri fails to establish, beyond a reasonable doubt, conception of the invention of the count prior to December 29, 1962, the record date of Grant.

2. The record for Silvestri fails to establish, beyond a reasonable doubt, actual reduction to practice of the invention of the count prior to December 29, 1962.

3. Silvestri is entitled only to the filing date of the involved Silvestri application; namely, November 2, 1964 for conception and reduction to practice.

Judgment

Priority of invention of the subject matter of the sole count in issue is awarded to Norman H. Grant and Harvey E. Alburn, the senior party patentees.

BOARD OF PATENT INTERFERENCES

/s/ L. H. GASTON
L. H. Gaston
Examiner of Interferences

/s/ WALTER A. MODANCE
Walter A. Modance
Examiner of Interferences

/s/ G. K. MILESTONE
G. K. Milestone
Examiner of Interferences

CORRECTION TO OPINION AND DECISION OF BOARD OF PATENT INTERFERENCES, FEBRUARY 19, 1971.

The Board of Patent Interferences calls attention to the fact that on page 11, line 1 of their decision of January 15, 1971, the word "data" should be inserted between "analytical" and "is".

/s/ NEILL V. JOINER
Clerk, Board of Patent Interferences

APPENDIX D

EXCERPTS FROM RESPONDENTS' REASONS OF APPEAL FILED IN THE PATENT OFFICE

NOTICE OF APPEAL TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS, MARCH 16, 1971.

Honorable Commissioner of Patents
Washington, D.C. 20231

Sir:

Now comes Silvestri et al, the junior party, by their attorney, and give notice to the Commissioner of Patents, pursuant to Rules 301 and 302 of the Rules of Practice, of their appeal to the United States Court of Customs and Patent Appeals from the decision of the Board of Patent Interferences rendered on January 15, 1971, awarding priority of invention of the count in issue to the senior party, Grant et al, in the above-entitled case.

The reasons of appeal are as follows:

* * * * * * * * * *

31. The Board erred in stating that in answer to interrogatories by counsel for Grant, Brink, the attorney of record for Silvestri stated that he first made the factual determination that Silvestri and Johnson, the co-inventors had performed work, either themselves or others on their behalf, that allegedly constituted the invention claimed, soon after the involved Grant patent issued.

32. The Board erred in stating that the investigation leading up to the factual determination was made by Brink several months prior to the filing date of the involved Grant patent.

* * * * * * * * * *

51. The Board erred in stating that the appearance of the involved Grant patent on the scene was the spur that

led to or catalyzed the filing of the involved Silvestri application.

* * * * * * * * * *

Respectfully submitted,

/s/ Richard H. Brink
Richard H. Brink
Attorney for Silvestri et al

APPENDIX E

EXCERPTS FROM ANSWERS TO WRITTEN INTERROGATORIES BY RESPONDENTS' ATTORNEY RICHARD H. BRINK

IN THE UNITED STATES PATENT OFFICE
BEFORE THE BOARD OF PATENT INTERFERENCES

Interference No. 94,856

SILVESTRI ET AL

v.

GRANT ET AL

DEPOSITION OF RICHARD H. BRINK—ANSWERS TO WRITTEN INTERROGATORIES

I, RICHARD H. BRINK, answer the written interrogatories which were served upon me on March 17, 1970 as follows:

* * * * * * * * * *

3. Please state the name of your present employer and your occupation.

A. My present employer is Bristol-Myers Company.

I am a member of the Legal Division of Bristol-Myers Company.

* * * * * * * * * *

7. Please state when you first became aware of the issuance of U. S. Patent No. 3,144,445, issued August 11, 1964, in the names of Norman H. Grant and Harvey E. Alburn, and assigned to American Home Products Corporation.

A. I cannot state with certainty the date I first became aware of U. S. Patent No. 3,144,445. However, it was probably within one or two months after the issuance of that patent.

Without waiver of the attorney client privilege or of the privilege which attaches to the work product of an attorney, insofar as these privileges attach to the details of the investigation which I made following the issuance of U. S. Patent No. 3,144,445, the following answers are given to Questions 8-19:

8. Please state whether you made a factual investigation of the data resulting from or based on work done at Bristol Laboratories, Division of Bristol-Myers Company in an effort to locate infrared traces allegedly corresponding to the infrared trace which is Figure 1 of the Grant & Alburn patent identified above in Question 7.

A. Yes.

9. If the answer to Question 8 is yes, please give the date on which your said factual investigation began.

A. I cannot recall the exact date, but it was soon after I became aware of the patent.

* * * * * * * * * *

11. If the answer to Question 8 is yes, please give the date on which you first made the factual determination that Bristol's employees Herbert H. Silvestri and David A. Johnson had performed work, either themselves or by others on their behalf, that allegedly constituted the invention claimed in said Grant & Alburn patent several months prior to the filing date (December 26, 1962) of that patent.

A. I cannot recall the exact date, but it was probably soon after the time I became aware of the Grant & Alburn patent.

* * * * * * * * * *

14. Please state whether, to your knowledge, anyone else in or on behalf of Bristol Laboratories ever made a factual investigation of the kind referred to above in Question 8.

A. I have no knowledge that anyone else made such an investigation independent of the investigation which I made.

* * * * * * * * * *

/s/ Richard H. Brink
Richard H. Brink

March 24, 1970

Date

APPENDIX F

LETTER FROM THE CLERK OF THE CCPA INDICATING DENIAL OF PETITIONERS' PETITION FOR REHEARING AND MOTION TO VACATE AND REMAND

UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS
717 MADISON PLACE, N.W.
WASHINGTON, D. C. 20439

September 12, 1974

Mr. Ellsworth H. Mosher
Suite 600 Crystal Mall 1
1911 Jefferson Davis Highway
Arlington, Virginia 22202

Re: Silvestri et al v. Grant et al
P.A. 8978

Dear Sir:

The court denied the petition for rehearing today in the above appeal. The motion of appellees to vacate the decision and remand the case to the Board of Patent Interferences is denied.

Very truly yours,

(Signature illegible)

cc: Richard H. Brink
P.O. Box 657
Syracuse, New York 13201

Robert H. Berdo
1225 Conn. Avenue, N.W.
Washington, D.C. 20036

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1974

No. 74-727

NORMAN H. GRANT, ET AL.,
Petitioners

v.

HERBERT H. SILVESTRI, ET AL.,
Respondents

OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

Respondents respectfully submit that the petition for a writ of certiorari in this case should be denied for the reasons presented herein.

OPINIONS BELOW

The opinion of the United States Court of Customs and Patent Appeals (hereinafter referred to as the CCPA) is reprinted in Appendix B of the petition. The CCPA decision is also reported at 496 F.2d 593. The decision of the Board of Patent Interferences is reprinted in Appendix C of the petition.

JURISDICTION

The jurisdictional requisites are adequately set forth in the petition.

QUESTIONS PRESENTED

It is believed the first question presented by petitioners is too broadly stated to properly frame the issues and that the second question presented by petitioners does not accurately define the issue to be decided by this Court. Respondents submit the following as a more accurate statement of the question presented:

> In reviewing a decision of the Board of Patent Interferences, can the CCPA decide a question of law, which was not decided by the Board of Patent Interferences, having before it all of the evidence relating to this issue which was before the Board of Patent Interferences, where a decision on that question of law is necessary to decide priority of invention.

STATUTORY PROVISIONS INVOLVED

In addition to the statutory authorities cited by petitioners, respondents will refer herein to 35 U.S.C. § 6, 35 U.S.C. § 135, Rule 52(a) of the Federal Rules of Civil Procedure and Patent Office Rule 256(b) which are reprinted in Appendix 1.

STATEMENT OF THE CASE

Petitioners' statement of the case contains a number of unsupported allegations which are not essential for a consideration of the question presented and the following statement of the case is submitted.

Respondents contend that they are the first inventors of a new crystalline form of ampicillin having a low moisture content. This form of ampicillin is claimed in petitioners' patent, U.S. Patent No. 3,144,445 which issued August 11, 1964 on an application filed December

26, 1962, and in respondents' patent application Serial No. 408,191, filed November 2, 1964. The Patent Office declared an interference pursuant to 35 U.S.C. § 135 between petitioners' patent and respondents' application and respondents took testimony by way of depositions to prove that they had made the invention prior to the filing date of petitioners' application for patent. Petitioners did not present any evidence to show that they had made the invention earlier than the filing date of their patent and were therefore restricted to their filing date for their date of invention, *Goodale* v. *Lund*, 96 F.2d 840, (CCPA 1938).

The Board of Patent Interferences held that the evidence in respondents' record did not establish that they had made the invention before petitioners' filing date. The Board of Patent Interferences did not specifically decide the legal question, which was argued before it by petitioners, as to whether or not respondents had "abandoned, suppressed or concealed" the invention. Petitioners did not, as they might have done in accordance with the provisions of Patent Office Rule 256(b), request the Board of Patent Interferences to reconsider or modify its decision to specifically rule on the question of whether respondents had abandoned, suppressed or concealed the invention.

Respondents appealed the decision by the Board of Patent Interferences to the CCPA. Before the CCPA, petitioners not only argued that the Board of Patent Interferences was correct in holding that respondents had not established that they made the invention before petitioners' filing date, but they also argued that respondents had abandoned, suppressed or concealed the invention, see Appendix 2.

The CCPA reversed the decision of the Board of Patent Interferences on the issue of their reduction to practice, holding that the record showed a date of in-

vention by respondents prior to petitioners' filing date. However, the Court could not award priority to respondents without deciding the question of whether respondents had abandoned, suppressed or concealed the invention within the meaning of 35 U.S.C. 102(g) since petitioners had argued this point before it. It therefore looked at the evidence in the record before it, which was the same evidence produced before the Patent Office as required by 35 U.S.C. 144, and decided that respondents had not abandoned, suppressed or concealed the invention. Accordingly, the CCPA reversed the decision of the Board of Patent Interferences and awarded priority of invention to respondents.

ARGUMENT FOR DENYING THE WRIT

There is no need or occasion for a review of the decision by the CCPA in this case since there is no conflict with a decision of another court of appeals, the decision does not relate to an important question of federal law, it does not decide a federal question in a way in conflict with any decision of the United States Supreme Court and the decision does not represent a departure from the accepted and usual course of judicial proceedings.

Petitioners' sole reason for requesting that a writ of certiorari issue is based upon the fact that the CCPA decided the issue of abandonment, suppression and concealment, without this issue having been decided by the Board of Patent Interferences. Petitioners contend (1) that this is a case of first impression, representing the first time that this Court has had an opportunity to review a decision of the CCPA involving an appeal from the Board of Patent Interferences; (2) that the decision is in conflict with decisions of United States Courts of Appeals and with prior decisions of the CCPA; and (3) that the CCPA, in deciding the issue of abandonment, suppression and concealment, departed from normal pro-

cedures of appellate review. These contentions are without merit. Petitioners' real claim to error appears to be based upon the bare fact that the Patent Office was reversed by the CCPA.

Before considering petitioners' arguments in detail, it should be noted at the outset that the facts bearing on the issue of abandonment, suppression or concealment were fully developed before the Board of Patent Interferences. Petitioners themselves vigorously argued the question of abandonment, suppression and concealment before the Board and the CCPA in their brief, see pages 24-27 of petitioners' brief before the CCPA, which pages are attached hereto as Appendix 2. Having themselves asked the CCPA to decide this issue in their favor, petitioners should not now be heard to say that the CCPA should not have decided the issue at all. Thus, it is respectfully submitted that petitioners should be estopped from contending that the CCPA should not have decided the issue of abandonment, suppression or concealment.

At page 8 of their petition, petitioners allege that they only argued the question of abandonment, suppression or concealment before the CCPA because respondents argued this issue in their brief. However, if this were the case, would not petitioners have included in their brief before the CCPA a section arguing petitioners' present contention, viz., that the CCPA does not have the authority to decide this issue and that, if the CCPA held in favor of respondents on the issue of reduction to practice of the invention, the CCPA should then remand the case to the Patent Office for it to decide the issue of abandonment, suppression or concealment? However, petitioners' brief before the CCPA made no such contention and affirmatively asked that Court to decide this issue.

It is submitted that petitioners argued the question of abandonment, suppression or concealment before the CCPA because they knew full well that the CCPA could,

in accordance with its established practice, decide this issue without it having been decided by the Board of Patent Interferences, since *all* questions pertinent to the issue of priority were before it. Indeed, the very decision cited by petitioners at page 7 for the proposition that they could not appeal to the CCPA since they prevailed before the Board of Patent Interferences, *Klemperer* v. *Price*, 271 F.2d 743 (CCPA 1959) states that:

> "It has been repeatedly held by this court, however, that all questions pertinent to the issue of priority of invention are before the court in considering an appeal from the Board of Patent Interferences. . . ."

The long-standing practice in the CCPA has been to consider issues when necessary to a priority decision *even though not specifically passed upon below*, see *Gianladis* v. *Kass*, 324 F.2d 322 (CCPA 1963); *St. Pierre* v. *Harvey*, 233 F.2d 337 (CCPA 1956); and *Sloan* v. *Peterson*, 129 F.2d 330 (CCPA 1942).

The fact that the CCPA will consider an issue not specifically passed upon below based upon the record below is not unique to that court. This Court has itself held that it is not limited in its scope of review but

> ". . . must enter the judgement which should have been rendered by the Court below on the record there before it"

Langes v. *Green*, 282 U.S. 531 (1931); and *Baker* v. *Warner*, 231 U.S. 588 (1913). And, in the *M.O.S. Corporation* v. *John I. Haas Co.*, 375 F.2d 614 (CA 9 1967), it was held that if the issue of validity was litigated in the District Court in a patent infringement case and if the record presented is such as to permit decision on that issue, the Court of Appeals can, and at least where the answer seems clear, should decide the issue of patent validity *even though the District Court did not.*

1. This Is Not a Case of First Impression

Petitioners argue that "this is a case of first impression" and point out that this Court has never reviewed a decision of the CCPA involving an appeal from a determination of the Board of Patent Interferences. However, this Court has declined such opportunities several times in the past in petitions for review on writs of certiorari in intereference cases from the CCPA, see *Switzer et al.*, v. *Sockman et al.*, 333 F.2d 935 (CCPA 1964), cert. denied, 380 U.S. 906 (1965); *Knowles* v. *Tibbetts*, 347 F.2d 591 (CCPA 1965), cert. denied, 383 U.S. 927 (1966); *Krantz et al.*, v. *Olin*, 356 F.2d 1016 (CCPA, 1966), cert. denied 386 U.S. 982 (1967); *Carlson* v. *Woofter*, 367 F.2d 436 (CCPA 1966), cert. denied, 389 U.S. 847 (1967); *Fredkin* v. *Irasek*, 397 F.2d 342 (CCPA 1968), cert. denied 393 U.S. 980 (1968); *Frilette et al.*, v. *Kimberlin et al.*, 412 F.2d 1390 (CCPA 1969), cert. denied 396 U.S. 1002 (1970); and *Kilby* v. *Noyce*, 416 F.2d 1391 (CCPA 1969), cert. denied 400 U.S. 818 (1970).

Thus, Petitioners' allegation that this Court can, for the first time in the history of the patent laws, consider a decision of the CCPA involving an appeal from the Board of Patent Interferences is somewhat misleading since the Court could have considered such a decision in any one of the foregoing cases.

Petitioners contend at pages 9 and 12 that the effect of the CCPA's decision may extend the patent monopoly on the invention in issue from 17 to 28 years. However, this is no reason for reversing the CCPA decision and remanding it to the Board of Patent Interferences and, in fact, is an excellent reason for *not* doing so. Thus, if the case were remanded to the Board of Patent Interferences for further proceedings, the Board would then be required to render a decision as to whether respondents had abandoned, suppressed or concealed the in-

vention. That decision, regardless of the outcome, would doubtedlessly either again be appealed to the CCPA or review thereof would be sought under 35 U.S.C. § 146. Such proceedings would require several years, and, assuming respondents prevailed, the period of exclusivity would be even *more* prolonged than if a patent were issued to respondents in the relatively near future.

2. Decision Not In Conflict With Decisions of U.S. Courts of Appeals or With Prior Decisions of CCPA

Petitioners complain the CCPA erred in making "findings of fact" on the issue of abandonment, suppression or concealment. However, the question of abandonment, suppression or concealment is not one of fact, but is an ultimate question of law, *Brokaw* v. *Vogel*, 429 F.2d 476 (CCPA 1970). In one of their briefs filed before the CCPA, petitioners agreed that the question of abandonment, suppression or concealment is an ultimate conclusion of law but argued that it must be based on findings of fact, see Appendix 3. However, since 35 U.S.C. § 144 provides that the CCPA shall hear and determine an appeal "on the evidence produced before the Patent Office", it is respectfully submitted that it was well within the power of that court to consider and decide the legal question of abandonment, suppression or concealment based upon the evidence produced before the Patent Office, even though that question was not decided by the Board of Patent Interferences.

Moreover, even assuming arguendo that the court did make "findings of fact" in deciding the legal question of abandonment, suppression or concealment, it is respectfully submitted that the CCPA is well within its authority in making a finding of fact from the record before it under the provisions of 35 U.S.C. 144. All of the evidence relating to this issue which was considered by the CCPA was identical to the evidence that was

before the Board of Patent Interferences and none of the evidence was disputed.

The large number of United States Court of Appeals decisions cited at page 14 of the petition and petitioners' argument that United States Courts of Appeals generally remand cases to the lower court to make findings of fact are not apropros. United States District Courts *must* make findings of facts under the provisions of Rule 52(a) of the Federal Rules of Civil Procedure. However, this rule does not apply to the Patent Office and there is no requirement in the Patent Office rules, which have been promulgated under 35 U.S.C. § 6 by the Commissioner of Patents and approved by the Secretary of Commerce, that the Board of Patent Interferences should make specific findings of fact.

Moreover, even a Court of Appeals may make its own findings of fact where the evidence is all documentary and it is in as good a position as the trial court to examine the evidence, *Borden Company* v. *Clearfield Cheese Co.*, 369 F.2d 96, 101 (CA 3 1966). In the present case, the evidence before the Board of Patent Interferences was in the form of depositions and the CCPA was in as good a position as the Patent Office to examine this evidence.

The three ex parte cases cited at page 14 of the petition are not pertinent. In each of these cases, the CCPA remanded to the Patent Office Board of Appeals for clarification of a rejection which the Board had made and *not* to decide a question which it had not decided in its original opinion.

Petitioners argue that the CCPA has in the past remanded cases to the Board of Patent Interferences to obtain its views on the question of abandonment, suppression or concealment when this issue was not decided by the Board of Interferences and that it should have done

so in this case. However, it is clear that it is within the discretion of the CCPA to decide an issue not decided below, see *Gianladis* v. *Kass*, 324 F.2d 322 (CCPA 1963); *St. Pierre* v. *Harvey*, 233 F.2d 337 (CCPA 1956); and *Sloan* v. *Peterson*, 129 F.2d 330 (CCPA 1942). Indeed, one of the very cases cited by petitioners for the proposition that the CCPA should remand the case to the Board of Interferences for further proceedings, *Myers* v. *Feigelman*, 455 F.2d 596 (CCPA 1972) specifically held that the CCPA undoubtedly *does have the power* to proceed on its own and decide questions not reached by the Board which become relevant only because it has reversed the Board on questions which it did reach.

Petitioners' contention fails to recognize the distinction between what a court actually does and what it has the *power* to do. In *Langnes* v. *Green*, 282 U.S. 531 at 538, this Court stated as follows:

> "These decisions simply announce a rule of practice which generally has been followed; but none of them deny the *power* of the court to review objections urged by respondent, although he has not applied for certiorari, if the court deems there is good reason to do so."

So also, the decisions cited by petitioners simply announce the rule of practice which may be followed by the CCPA, but none of them deny the *power* of the CCPA to decide an issue which has not been decided by the Board of Interferences.

Moreover, even if the case were remanded to the Board of Patent Interferences, it is not seen how the Board could possibly come up with a different decision as to abandonment, suppression, or concealment than the CCPA did. The Board would necessarily base its decision on the same evidence which was before the CCPA. Surely, the Board would not arrive at a different conclusion of law based upon the evidence than the decision already reached

by the CCPA, and, if they did reach a different conclusion, the CCPA would surely reverse upon a further appeal.

3. The CCPA In Deciding Issue of Abandonment, Suppression And Concealment Did Not Depart From Normal Procedures Of Appellate Review

Much of what is set forth in the section on pages 16-19 of the petition is a rehash of arguments which petitioners have made in earlier sections. Accordingly, much of what has been said earlier in this opposition is applicable to the arguments made in this section of the petition and will not be repeated herein.

None of the cases cited in this section of the petition stands for the proposition that the CCPA should desist from deciding an issue not considered by the Patent Office when a determination of that issue is necessary to a priority decision. The cited ex parte cases of *In re Tucker*, *In re Mooney*, and *In re Kalter* are not pertinent to an inter partes case since those decisions merely state that the CCPA cannot rule upon a rejection which was not made by the Patent Office Board of Appeals. The fact that the CCPA does not have the authority to make a new ground of rejection has nothing to do with its authority to decide an issue not decided by the Board of Patent Interferences when necessary to a priority decision.

The *National Polychemicals Inc.* v. *U.S.* case discussed at page 17 of the petition is wholly irrelevant. In that case, the CCPA merely stated the obvious, i.e., that it is not a trier of facts. In the present case, the CCPA did not become "a trier of facts" since it decided the issue of abandonment, suppression or concealment based upon the evidence which was developed before the Board of Patent Interferences. The *National Polychemicals Inc.* case does not state that the CCPA could not have de-

cided questions which had not been decided by the Customs Court based upon the evidence before it.

Petitioners further contend that the CCPA should not have decided the issue of abandonment, suppression or concealment since the failure of the Board of Patent Interferences to rule on this point was not set forth as a reason for appeal. However, the reasons for appeal, which are set forth in Appendix 4, clearly did put this issue before the CCPA. Thus, the first and second reasons for appeal, i.e., that the Board erred in awarding priority of invention to petitioners and that the Board erred in not awarding priority of invention to respondents, clearly required the CCPA to decide the issue of abandonment, suppression or concealment. Since both petitioners and respondents vigorously argued the issue of abandonment, suppression or concealment before the CCPA, that Court could not have awarded priority to respondents without deciding that issue.

Furthermore, reasons for Appeal Nos. 31, 32 and 52 each set forth points of error in the decision by the Board of Patent Interferences which relate to the issue of abandonment, suppression and concealment. A single adequate reason of appeal is sufficient to bring an issue before the CCPA, *Ferree* v. *Shephard*, 384 F.2d 1019 (CCPA 1967).

Moreover, even if the question of abandonment, suppression or concealment were not referred to in the reasons of appeal, the CCPA still would have had the authority to decide this issue since it is a question ancillary to priority, *Kratz et al.* v. *Calvert*, 129 F.2d 542 (CCPA 1942).

Finally, this is not the type of case which could be summarily decided in petitioners' favor as was done in *Camp* v. *Pitts* cited at page 19 of the petition. In the *Camp* v. *Pitts* case, this Court summarily held that under

the National Bank Act and the Administrative Procedure Act, a party who is dissatisfied with a ruling of the Comptroller of the Currency is not entitled to a trial *de novo* in a United States District Court. It reached this decision citing a previous decision of this Court, i.e., no new precedent was established. However, if this Court were to remand this case to the Board of Patent Interferences as requested by petitioners, it would clearly set a precedent by indicating that the CCPA does not have the power to decide an issue not decided by the Board of Patent Interferences on the evidence which was before the Board when a decision of that issue is necessary to a determination of priority.

CONCLUSION

The CCPA unanimously concluded based upon the record which was before the Board of Patent Interferences, that respondents had not abandoned, suppressed or concealed the invention. The only issue before this Court is whether the CCPA's decision on this point, based upon the very facts and documents as were before the Board of Patent Interferences and which were fully developed before the Board, was capricious, arbitrary, or clearly erroneous. Respondents submit that the CCPA decision was proper and therefore respectfully urge this Court to deny the petition for review on writ of certiorari to the Court of Customs and Patent Appeals.

Respectfully submitted,

ROBERT H. BERDO
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Of Counsel:

ROYLANCE, ABRAMS, BERDO & KAUL

January 1975

APPENDIX 1

RELEVANT STATUTES AND RULES

35 USC § 6 Duties of Commissioner

The Commissioner, under the direction of the Secretary of Commerce, shall superintend or perform all duties required by law respecting the granting and issuing of patents and the registration of trade-marks; and he shall have charge of property belonging to the Patent Office. He may, subject to the approval of the Secretary of Commerce, establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office.

35 USC § 135 Interferences

(a) Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be. The question of priority of invention shall be determined by a board of patent interferences (consisting of three examiners of interferences) whose decision, if adverse to the claim of an applicant, shall constitute the final refusal by the Patent Office of the claims involved, and the Commissioner may issue a patent to the applicant who is adjudged the prior inventor. A final judgment adverse to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims involved from the patent, and notice thereof shall be endorsed on copies of the patent thereafter distributed by the Patent Office.

(b) A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted.

Federal Rules of Civil Procedure, Rule 52.

FINDINGS BY THE COURT

(a) Effect. In all actions tried upon the facts without a jury or with an advisory jury, the court shall find the facts specially and state separately its conclusions of law thereon, and judgment shall be entered pursuant to Rule 58; and in granting or refusing interlocutory injunctions the court shall similarly set forth the findings of fact and conclusions of law which constitute the grounds of its action. Requests for findings are not necessary for purposes of review. Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses. The findings of a master, to the extent that the court adopts them, shall be considered as the findings of the court. If an opinion or memorandum of decision is filed, it will be sufficient if the findings of fact and conclusions of law appear therein. Findings of fact and conclusions of law are unnecessary on decisions of motions under Rules 12 or 56 or any other motion except as provided in Rule 41(b).

Patent Office Rule 256(b)

(b) Any request or petition for rehearing or reconsideration, or modification of the decision, must be filed within thirty days from the date of the original decision, unless that decision is so modified as to become, in effect, a new decision, and the Board of Patent Interferences so states. Any reply thereto must be filed within fifteen days from the filing of the petition. (See rule 304.)

APPENDIX 2

EXCERPT FROM PETITIONERS' BRIEF BEFORE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

IN THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

Patent Appeal Docket No. 8978

SILVESTRI, ET AL.,
Appellants,
v.
GRANT, ET AL.,
Appellees.

Appeal From the Board of Patent Interferences
(Interference No. 94,856)

APPELLEES' BRIEF

* * * * *

Assuming Arguendo an Actual Reduction to Practice, Silvestri Abandoned, Suppressed or Concealed the Invention and Was Spurred Into Activity Only Upon Seeing the Grant Patent Issue in August of 1964

Although Grant respectfully submits that Silvestri has utterly failed to establish beyond a reasonable doubt an actual reduction to practice in 1962 as alleged by Silvestri, the record makes it abundantly clear that *if* Silvestri

can be regarded as having proved an actual reduction to practice at that time, he abandoned, suppressed or concealed it and did not revive any interest in it until spurred into activity by the issuance of the Grant patent in August of 1964.

Thus, if it be assumed *arguendo* that Silvestri was in possession of the invention in the spring or summer of 1962, why then did Silvestri fail to *disclose* that invention in his parent application filed in October of 1962? The answer seems obvious; he either was not aware of it or he abandoned, suppressed or concealed it. A rather strong presumption adverse to Silvestri arises from his failure to disclose the invention in his parent application of October 1962. See *Ellis* v. *Scott et al*, 43 App. D.C. 441 (1915).

If Silvestri was in possession of the invention in the spring or summer of 1962, why was it when he filed his new drug application that he *intended* that the new drug application should be for the *trihydrate*, as admitted by Dr. Frediani (R. 1129, Q 81-83). The answer seems obvious. The answer *is* obvious: Silvestri simply was not in possession of the invention in 1962, or else he abandoned, suppressed or concealed it. So far as the record shows, were it not for the issuance of Grant's patent the invention defined by the count would be lost to the world.

If Silvestri was in possession of the invention defined by the count in the spring or summer of 1962, why is it that the invention record or invention disclosure submitted to the assignee by the inventors (Grant's Cross-Exhibit 1) was completely silent concerning that invention? See Dr. Johnson's admission at R. 201, X Q 177. It was conceded that there was no separate invention record for the later Silvestri II application directly involved in this interference (R. 190-1). The only logical inference is that Silvestri simply was not in possession

of the invention at that time or that he had abandoned it.

When the Grant patent issued in August of 1964, it came to Dr. Johnson's attention some time shortly thereafter, perhaps a month later. Dr. Johnson admitted on cross-examination that he assumed he first saw the Grant patent "fairly soon" after its issue date (R. 164-5, X Q 60-61) and probably in September of 1964 (R. 165, Q 65).

On this clear suggestion of spurring into activity, the answers to written interrogatories of Richard H. Brink, one of the attorneys for Silvestri, are also highly pertinent (R. 1207-10). Mr. Brink admitted that he first became aware of the issuance of the Grant patent at some indeterminate date "probably within one or two months after the issuance of that patent" (Inter. No. 7). (R. 1208). He admitted further that he had conducted a factual investigation of data resulting from or based upon work done at Bristol Laboratories to locate infrared traces allegedly corresponding to the infrared trace which is Fig. 1 of the Grant patent and that he began that factual investigation at some indeterminate date soon after he became aware of the patent (Inter. 8 and 9) (R. 1208). His initial investigation was completed some time *prior* to the filing of the Silvestri II application on November 2, 1964 (Inter. 10). (R. 1208) Mr. Brink admitted that so far as he was aware *no one else* had ever made a factual investigation of the kind just indicated independent of his own investigation (Inter. 14). (R. 1209). It appears from Mr. Brink's answer to Inter. 16 that he was responsible for preparing and filing the Silvestri II application of 1964. (R. 1209). From his answer to Inter. 19, R. 1209, it appears that it was Mr. Brink who retrieved the I R curves for various materials, including 12 CD 61, that had lain buried in the Bristol Laboratory files, and with Mr. Joseph Bomstein

determined or confirmed the alleged fact that the I R trace for 12 CD 61 was substantially identical to the I R trace of Fig. 1 of the Grant patent."

A stronger showing of a spurring into activity would be hard to imagine. The classic doctrine of *Mason* v. *Hepburn*, 13 App. D.C. 86 (1898), clearly applies. See also the more recent cases of *Woofter* v. *Carlson*, 54 CCPA 917, 367 F.2d 436 (1966) and *Engelhardt* v. *Judd et al*, 54 CCPA 865, 369 F.2d 408 (1966).

Also of great interest is the old case of *Halbleib* v. *Bendix et al*, 50 App. D.C. 247 (1921), for the reason that there the time period of spurring into activity between the successful test by one Bijur of his device ("the early part of 1912") and the time when Bijur "made any attempt to *resurrect* or commercialize his device" after seeing Bendix's device at an automobile show ("in January and February, 1914") is of the same order of magnitude as the corresponding time period here, which is from the spring or summer of 1962 to or shortly after August of 1964 when Grant's patent issued.

---

[10] These facts loom up with especial significance when it is recalled that one of Silvestri's star witnesses (Donald Marquette who at the time was project supervisor in the pilot plant—R.208, Q. 17) admitted when called as a witness by Grant that the procedure of Dr. Johnson's memorandum of April 2, 1962 (SE 5) was not carried out after approximately the Fall of 1962 (R. 1152, Q. 29). This admitted cessation of activity in the Fall of 1962 in respect of the boasted procedure of Dr. Johnson assumes added significance when measured against the admission of Dr. Johnson (and a different co-applicant) made in his later-filed patent No. 3,157,640 (SE 4) at column 1, lines 53-60:

> "However, due to the fact that anhydrous (D-(—)-*α*-aminobenzylpencillin is soluble in water to the extent of about 20-25 mg./ml. at 20-25° C., it is very difficult to recover the product in high yields. Furthermore, the recovered (D-(—)-*α*-aminobenzylpencillin may be obtained in the form of a monohydrate. The monohydrates (as well as the dihydrates) of D-(—)-*α*-aminobenzylpencillin possess poor biological stability."

It is true that—even assuming *arguendo* an actual reduction to practice by Silvestri in 1962—Grant sustained his burden of proving by at least the preponderance of the evidence Silvestri's abandonment, suppression or concealment of the invention defined by the count (plus spurring into activity by and shortly after the issuance of Grant's patent) solely from the examination or cross-examination of witnesses produced by or on behalf of *Silvestri*. But, as was stated by Mr. Chief Justice Taft for the Supreme Court of the United States in *Eibel Process Co.* v. *Minnesota & Ontario Paper Co.*, 261 U.S. 45 at 53 (1923): "A case that can be made out in all its elements by cross-examination of opposing witnesses is a strong case."

* * * * *

Respectfully submitted,

VITO VICTOR BELLINO
ANDREW KAFKO
ELLSWORTH H. MOSHER
Attorneys for the Appellees

December 1972

APPENDIX 3

EXCERPT FROM REPLY BY GRANT et al. TO THE SILVESTRI et al. MOTION TO VACATE AND REMAND

IN THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

Patent Appeal Docket No. 8978

SILVESTRI, ET AL.,
Appellants

v.

GRANT, ET AL.,
Appellees

REPLY BY GRANT ET AL TO THE SILVESTRI ET AL OPPOSITION TO THE GRANT ET AL MOTION TO VACATE AND REMAND

* * * * *

Grant agrees with Silvestri that the question of abandonment, suppression or concealment is "an *ultimate* conclusion of law". Nevertheless that ultimate conclusion of law cannot rationally be arrived at *in a vacuum*. It must be based on relevant findings of fact. It is Grant's position that under the law such findings of fact should have been made *in the first instance* by the Board of Patent Interferences and not by this Court.

* * * * *

Respectfully submitted,

Of Counsel:
JOSEPH SCHIMMEL

August 8, 1974

VITO VICTOR BELLINO
ANDREW KAFKO
ELLSWORTH H. MOSHER
Attorneys for the Appellees

By Ellsworth H. Mosher
ELLSWORTH H. MOSHER

APPENDIX 4

REASONS FOR APPEAL

IN THE UNITED STATES PATENT OFFICE

Interference No. 94,856

SILVESTRI ET AL

v.

GRANT ET AL

NOTICE OF APPEAL TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS AND REASONS OF APPEAL

Honorable Commissioner of Patents
Washington, D.C. 20231

Sir:

Now comes Silvestri et al, the junior party, by their attorney, and give notice to the Commissioner of Patents, pursuant to Rules 301 and 302 of the Rules of Practice, of their appeal to the United States Court of Customs and Patent Appeals from the decision of the Board of Patent Interferences rendered on January 15, 1971, awarding priority of invention of the count in issue to the senior party, Grant et al, in the above-entitled case.

The reasons of appeal are as follows:

1. The Board erred in awarding priority of invention of the subject matter of the count in issue to the senior party, Grant et al.

2. The Board erred in not awarding priority of invention of said subject matter to the junior party, Silvestri et al.

3. The Board erred in holding that the party Silvestri et al was not entitled to the filing date, October 29, 1962, of their parent application Serial No. 233,943.

4. The Board erred in holding that the parent Silvestri application Serial No. 233,943 does not disclose the subject matter of the count.

5. The Board erred in affirming the Primary Examiner's holding that the parent Silvestri et al application, Patent No. 3,180,862, does not disclose the subject matter of the count.

6. The Board erred in holding that the involved Silvestri application contains much new matter as compared with the parent application.

7. The Board erred in holding that Johnson did not testify that the product of Example 13 of SE 2 was made by the method described in SE 5.

8. The Board erred in implying that disclosure of acylation of 6-APA with phenylglycyl chloride HCl is necessary in the parent Silvestri application to establish inherent production of the compound of the count.

9. The Board erred in holding that no correlation has been established between SE 2 and SE 5.

10. The Board erred in its interpretation of the decisions *Smith* v. *Wehn*, 50 CCPA 1554, 318 F2d 325, 136 USPQ 52; *Dreyfus et al* v. *Sternau*, 53 CCPA 1050, 357 F2d 411, 149 USPQ 63; *In re Nathan*, 51 CCPA 1059, 328 F2d 1005, 140 USPQ 601; and *Petisi et al* v. *Rennhard et al*, 53 CCPA 1452, 363 F2d 903, 150 USPQ 669, and particularly in the requirements for inherency.

11. The Board erred in holding that the invention of the count was not sufficiently identified or recognized in the parent Silvestri et al application.

12. The Board erred in not holding that the parent Silvestri application Serial No. 233,943 does inherently disclose the subject matter of the count.

13. The Board erred in finding that parent application Serial No. 233,943 of Silvestri et al does not constitute a constructive reduction to practice of the subject matter of the count.

14. The Board erred in deciding that the party Silvestri et al is not entitled to the benefit of the filing date October 29, 1962 of their parent application Serial No. 233,943 as a constructive reduction to practice of the subject matter of the count.

15. The Board erred in not finding that Examples 1 and 2 of Serial No. 233,943 produced the product of the count.

16. The Board erred in not finding the characteristics of the product of the count where inherent in the product of Examples 1 and 2 of Serial No. 233,943.

17. The Board erred in not finding that the physical properties defined in the count, i.e., crystalline state, water content, molecular weight, infrared absorbtion spectrum and storage stability, are inherent characteristics of the compound of the count and specific recitation of these properties in the Silvestri et al parent application is not necessary for a disclosure of the compound defined by the count.

18. The Board erred in failing to find that the process described in the parent application of Silvestri et al Serial No. 233,943 and Examples 1 and 2 of said application inherently produce the compound of the count.

19. The Board erred in stating on page 13 of its decision that the Silvestri parent application clearly does disclose the product of the count.

20. The Board erred in holding that the record for Silvestri et al failed to establish beyond a reasonable doubt, conception of the invention of the count prior to December 29, 1962, the record date of Grant et al.

21. The Board erred in not holding that the record for Silvestri et al did establish beyond a reasonable doubt, conception of the invention of the count prior to December 26, 1962.

22. The Board erred in finding no reference to nor recognition by Silvestri et al of the product of the count in SE 5.

23. The Board erred in failing to find any evidence or recognition or conception of the count by Silvestri et al prior to December 26, 1962, the record date of Grant et al.

24. The Board erred in its interpretation of the decision in *Heard* v. *Burton et al*, 51 CCPA 1502, 333 F2d 239, 142 USPQ 97.

25. The Board erred in holding that since Silvestri et al had no conception of the invention prior to Grants' record date, on this ground alone Silvestri et al cannot prevail.

26. The Board erred in holding that the record for Silvestri et al failed to establish, beyond a reasonable doubt, actual reduction to practice of the invention of the count prior to December 29, 1962, the record date of Grant et al.

27. The Board erred in not holding that the record for Silvestri et al established, beyond a reasonable doubt, actual reduction to practice of the invention of the count prior to December 26, 1962.

28. The Board erred in stating that the record for Silvestri et al does not establish an actual reduction to

practice of the invention of the count beyond a reasonable doubt.

29. The Board erred in implying that the procedure outlined in memorandum SE 5 involved only the acylation of 6-APA with D-phenylglycyl chloride HCl.

30. The Board erred in stating that the product obtained by the acylation of 6-APA with D-phenylglycyl chloride HCl was referred to at Bristol as "P 50".

31. The Board erred in stating that in answer to interrogatories by counsel for Grant, Brink, the attorney of record for Silvestri stated that he first made the factual determination that Silvestri and Johnson, the co-inventors had performed work, either themselves or others on their behalf, that allegedly constituted the invention claimed, soon after the involved Grant patent issued.

32. The Board erred in stating that the investigation leading up to the factual determination was made by Brink several months prior to the filing date of the involved Grant patent.

33. The Board erred in finding that Johnson's testimony that 12 CD 61 "would probably be free of bound water" required corroboration and was not corroborated.

34. The Board erred in not finding that Run Nos. 80C P50, 82AA P50, 85A P50, 90A P50, 94A P50, 104 P50, 105 P50 and 122 P50, and the testing of the compound obtained, each constituted a reduction to practice of the invention of the count by Silvestri et al.

35. The Board erred in not finding that the products identified as 12 CD 57, 12 CD 61, 12 CD 63, 12 CD 71, 12 CD 82, 12 CD 100, 12 CD 106, 12 CD 107, 12 CD 131 and K2036 were established by Silvestri et al to have the characteristics of the compound of the count.

36. The Board erred in not finding that the form of anhydrous D-α-aminobenzylpenicillin of the count is dis-

tinguished from the form of anhydrous D-α-aminobenzylpenicillin which is the subject matter of U.S. 3,472,841 by its distinctive infrared spectrum.

37. The Board erred in not finding that Mr. Hull and Dr. Pollak recognized from the infrared spectrographs that a new form of anhydrous ampicillin had been prepared.

38. The Board erred in relying on the testimony of Mr. Marquette to explain a notation made by the person who performed the infrared analysis on 12 CD 61.

39. The Board erred in implying that there was any need for Johnson to testify "on the nature of the available standard".

40. The Board erred in misinterpreting Hull's testimony regarding an I.R. standard and in ignoring Hull's and Pollak's testimony relating to a comparison of infrared spectographs which they ran to a standard.

41. The Board erred in considering the contemporaneous conclusions of Bomstein while ignoring the contemporaneous conclusions of Hull and Pollak.

42. The Board erred in not holding that Bomstein's testimony did establish that the I.R. curves of lots such as 12 CD 57, 12 CD 61 and 12 CD 63 were the same as Figure 1 of the Silvestri et al application.

43. The Board erred in stating that they find no progress reports at Bristol directed to the invention of the count while ignoring contemporaneous documentary evidence which is of record.

44. The Board erred in finding that there was no evidence in the record of Silvestri et al to establish the preparation and identification of the compound of the count, the testing of said compound for utility, nor corroboration of preparation, identification and utility testing prior to the record date of Grant et al.

45. The Board erred in failing to find that testing of the compound of the count is unnecessary, since the utility is obvious.

46. The Board erred in failing to find that the utility of the compound of the count was established by Silvestri et al by testing the compound against *Staphylococcus aureus*.

47. The Board erred in holding that the compounds tested against *Staphylococcus aureus* were not established by Silvestri et al to be the compound of the count "but rather P 50".

48. The Board erred in failing to find that the analytical work done by various personnel at Bristol inures to the benefit of Silvestri et al.

49. The Board erred in failing to find that the samples of Form II ampicillin sent to the FDA correspond to the compound of the count.

50. The Board erred in failing to find that the certificates of analyses and the Finished Product Specifications submitted to the FDA all described the compound of the count and are evidence of a conception and a reduction to practice of the invention of the count.

51. The Board erred in stating that the appearance of the involved Grant patent on the scene was the spur that led to or catalyzed the filing of the involved Silvestri application.

52. The Board erred in holding that Silvestri is entitled only to the filing date of the involved Silvestri

application; namely, November 2, 1964 for conception and reduction to practice.

Respectfully submitted,

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Of Counsel:

Robert H. Berdo
James Magee, Jr.

March 16, 1971

SUPREME COURT, U. S.
FILED
JAN 31 1975
MICHAEL RODAK, JR., CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1974

No. 74-727

NORMAN H. GRANT, ET AL., *Petitioners*

v.

HERBERT H. SILVESTRI, ET AL., *Respondents*

PETITIONERS' REPLY

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January 31, 1975

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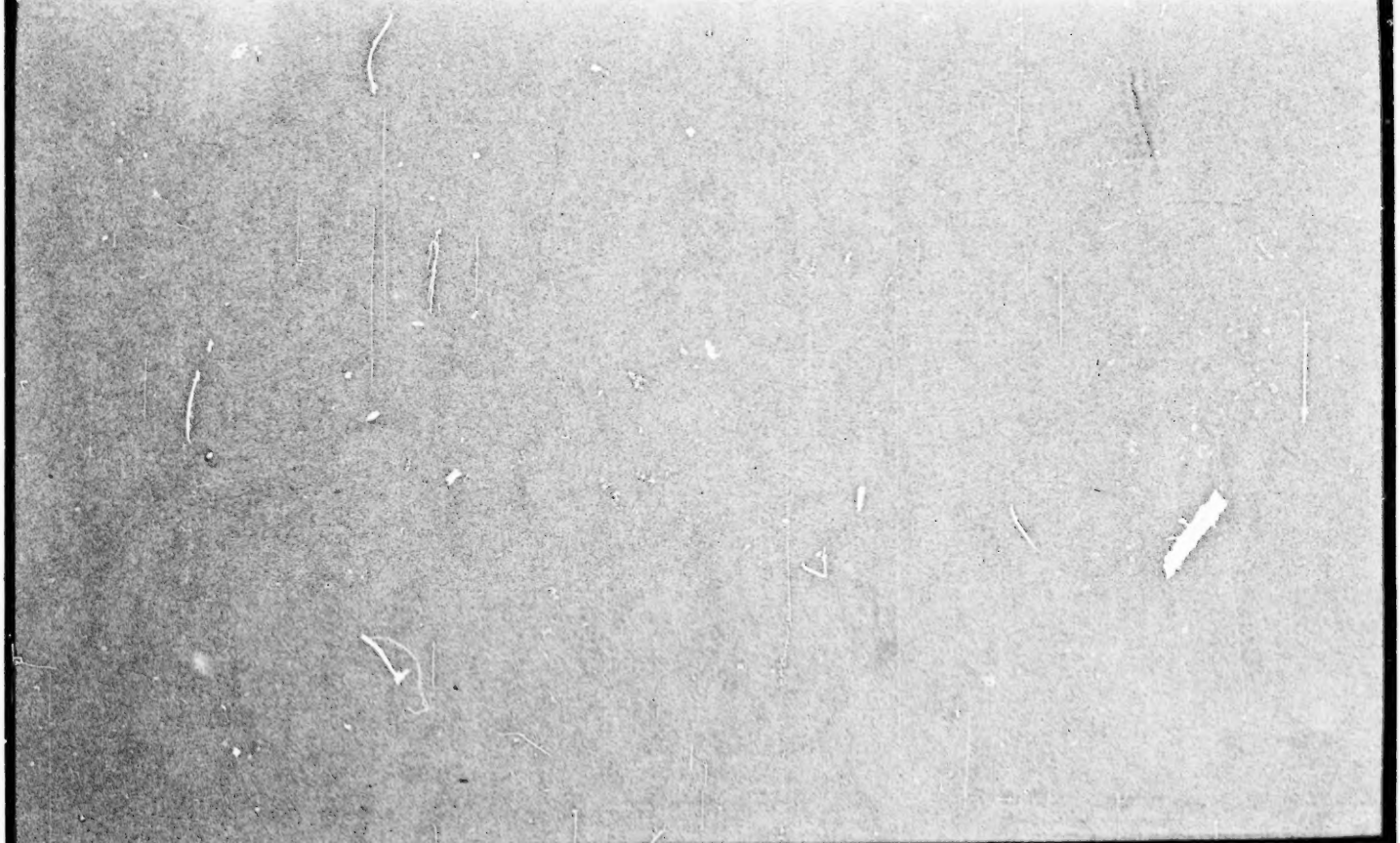

IN THE

Supreme Court of the United States

OCTOBER TERM, 1974

No. 74-727

NORMAN H. GRANT, ET AL., *Petitioners*

v.

HERBERT H. SILVESTRI, ET AL., *Respondents*

On Petition for a Writ of Certiorari to the United States Court of Customs and Patent Appeals

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PETITIONERS' REPLY MEMORANDUM

Respondents' Opposition wholly misconceives the reasons why petitioners urge the Court to take this case. Of course petitioners seek ultimately to prevail on the merits. To do so, this Court must now step in. But clearly that is no sufficient reason for this Court to grant a writ of certiorari. And the petition is based on no such argument. Therefore, respondents' opposition stressing the merits of this case is beside the point.

I.

Petitioners have indicated this is a case of first impression. Respondents attempt to meet that claim by pointing out that the Court has on a number of previous occasions denied petitions for a writ of certiorari to the Court of Customs and Patent Appeals in cases arising out of decisions of the Board of Patent Interferences. However, they cannot point to a single case —because none exists—in which this Court has *granted* the writ. Petitioners suggest that this important phase of the work of the Patent Office and of the CCPA in reviewing that work urgently needs a first look by this Court. Respondents cite no reason why it does not.

Quite aside from its novelty, this is an important case: First, because the interference practice involves a significant number of patents and probably a high proportion of the patents most important to the Nation's economy.[1] The integrity of that practice in accordance with the statutory scheme and with the concepts of due process should be assured. Second, the very patent here at issue is related to an important

[1] Without having undertaken a statistical analysis to support this assumption, petitioners believe it is probably true. The fact that an interference is declared reflects that at least two parties were working on the same problem and claim to have solved it in essentially the same way. This suggests a breadth of recognition of a problem requiring solution. Further, interference proceedings tend to be lengthy, complex and, accordingly, expensive. They are generally not pursued without the strong economic incentive that the emerging patents are likely to be of genuine significance. The last available annual report of the Patent Commissioner indicates that during the fiscal year ended June 30, 1973 there were 631 interferences then pending before the Board and that during the same year 383 new cases were declared. Commissioner of Patents Annual Report Fiscal Year 1973, Table 12, p. 13 (1973).

pharmaceutical product on which the patent monopoly will be extended at least nine years unless the decision below is reversed.

II.

Petitioners' second reason for requesting a writ is that the decision of the CCPA in this case conflicts both with other decisions of the coordinate Courts of Appeals and with its own precedents. Respondents attempt to meet that point by arguing that the Board of Patent Interferences is not bound by the Federal Rules of Civil Procedure and that, accordingly, the CCPA is not bound by the same review criteria as the other Courts of Appeals. Further, they cite some decisions of Courts of Appeals which might be in accord with what petitioners view as an aberrational role for an appellate tribunal.

Petitioners do not contend that the Board of Patent Interferences is bound by Rule 52 of the Federal Rules of Civil Procedure. They do urge this Court to interpret for the first time the statutes under which the relationship between the Board and the CCPA is delineated. They do ask this Court to instruct the CCPA on its proper role as an appellate tribunal. On the only two occasions that this Court has reviewed on the merits decisions of the CCPA, the CCPA's decisions have been found lacking.[2] But the CCPA is an important court. As in this case, its decisions can have an impact far wider than on the parties before it. Its work not only deserves, it demands, greater scrutiny by this Court.

Petitioners' argument is simply this: In patent cases, as elsewhere, the trial tribunal and not the appellate

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[2] *Brenner* v. *Manson*, 383 U.S. 519 (1966); and *Gottschalk* v. *Benson*, 409 U.S. 63 (1972).

tribunal has the duty and responsibility to make the initial, critical factual determinations on which a legal decision is then based. This is the preferred rule among the Courts of Appeals. It is an occasional rule of the CCPA. In a decision of November 14, 1974, that Court, itself, indicated that in interferences it recognizes the desirability of referring to the Board the job of finding the facts for "the avoidance of a possible miscarriage of justice." *Mikus and Shaffer v. Wachtel*, 504 F.2d 1150, 1152 (CCPA 1974).[3] Petitioners ask not only why they are not also to be accorded a procedure "to avoid injustice," but whether this Court should not intervene to give some direction and uniformity to the CCPA's procedures in patent cases.

Petitioners' point is not to argue whether the determinations of the initial trier of facts must be formally denominated "Findings of Fact" or whether the Commissioner of Patents must adopt that terminology for contested cases under his jurisdiction. Their point is

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[3] There is an added reason why it is an "injustice" for the CCPA, itself, to become the first trier of facts. By ruling in the first instance on such an issue against the *appellee* in a case before it, the procedure effectively denies that party the statutory right it would have were it a party against whom the *Board* had ruled to elect review either by the CCPA under 35 USC § 141 or by a United States District Court under 35 USC § 146. And in a District Court proceeding under § 146, the party aggrieved could seek to discover and introduce additional evidence bearing on the issue if it felt that the Board's ruling was unsupported by the existing record. However, when the CCPA usurps the role of initial fact finder, the party against whom the finding is made has an opportunity for review by *neither* the District Court *nor* another, independent appellate agency. It has, at most, the twin and heretofore theoretical opportunities to seek review by rehearing by the CCPA itself or certiorari from this Court.

that if the Court of Customs and Patent Appeals is to be what Congress has said it is supposed to be—an Article III court coordinate with the United States Courts of Appeals—it must act as an appellate court. That implies an obligation to *review* determinations by an initial fact finder. Arrogating such a role to itself is not what Congress meant. Worse, as here, it denies the party against whom such a finding is made, any meaningful opportunity for appellate review.

III.

Respondents' misconception of petitioners' arguments is perhaps best illustrated by their discussion of petitioners' third reason for granting the writ, namely, that the CCPA's action departs from normal procedures of appellate review. They say

> "the CCPA did not become 'a trier of facts' since it decided the issue of abandonment, suppression or concealment based upon the evidence which was developed before the Board of Patent Interferences." Opposition, p. 11.

They go on to say that

> "that court could not have awarded priority to respondents without deciding that issue." Opposition, p. 12.

It is petitioners' point that the CCPA erred precisely because it was the first body to decide the issue of abandonment, suppression or concealment based on its view of the evidence. What else does it mean to be a "trier of facts"? It is obviously being a "trier" if one first decides what the facts are that lead to a particular legal conclusion. Similarly, when respondents speak of the CCPA's "award of priority"

they only confirm petitioners' argument that the CCPA is assuming a role it has not been given. It is not the function of the CCPA to award priority to anyone. It is the function of that Court to *review* the record of the proceedings before the agency of the Patent Office that by statute has the obligation to award priority. The CCPA can *affirm* or *reverse* those determinations; it cannot itself substitute itself for the Patent Office tribunal.[4]

On the very issue of abandonment, suppression and concealment with which petitioners are concerned, the recent decisions of the CCPA reflect a determination by that Court to substitute its own judgments for those of the Board. See, e.g., *Brokaw* v. *Vogel*, 429 F.2d 476 (CCPA 1970), in which the Board was reversed, and *Young* v. *Dworkin*, 489 F.2d 1277 (CCPA 1974), in which the Board was affirmed. Of all this the editors of Patent Law Perspectives can only and perhaps cynically point out that the CCPA "has refused to shackle itself with any rigid formula." 3 *Donner, Gambrell & Kayton, Patent Law Perspectives* § C.10 (1974 Developments).

It is the existence of decisions in *inter partes* patent cases by an unreviewed and effectively unreviewable

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[4] Respondents' suggestion that a remand for an initial decision by the Board would be meaningless in light of the influence the existing decision of the CCPA would have is an unwarranted reflection on the Board. If the decision of the CCPA is vacated by this Court, that decision *pro tanto* will be as though it had never existed. There is no reason to believe the Board would not in that event forthrightly and afresh consider all of the relevant evidence and make its own independent findings of fact and reach its own legal conclusions on the issue of abandonment, suppression or concealment, without regard to what might or might not happen "upon a further appeal."

Court of which petitioners complain. On behalf of all patentees they urge this Court to take its first look into the merits of this important matter.

IV

Respondents argue that this is not the type of case that should be summarily decided and remanded for further proceedings in accordance with this Court's interpretation of the law since this Court has never before decided the issue petitioners raise. They claim *Camp* v. *Pitts*, cited in the petition as an example of a case in which the Court granted a writ of certiorari and without oral argument or further briefs reversed and remanded for further proceedings, is distinguishable because there the Court's decision was squarely governed by precedent. In fact, *Camp* was not so governed. The Court noted that "Unlike *Overton Park* [the allegedly precedential and binding authority] in the present case there was contemporaneous explanation of the agency action." 411 U.S. at 143. The Court then went on to discuss the distinction and nevertheless reverse and remand summarily. This is a practice the Court has followed in a wide variety of cases, frequently in those which, as this one, present what is essentially a procedural issue requiring an interpretation of federal law or the Federal Rules. Whether that issue was or was not previously decided by the Court has never been controlling. See, e.g., *Phillips Petroleum Co.* v. *Texaco, Inc.*, 415 U.S. 125 (1974) (Claim seeking compensation for constituent of otherwise federally price-controlled gas sold to a private party does not "arise under the Constitution or federal law" for jurisdictional purposes); *Northcross* v. *Memphis Board of Education*,

412 U.S. 427 (1973) (Discretionary denial of attorneys' fees authorized under Emergency School Aid Act of 1972 requires statement of reasons); *United States* v. *Indrelunas*, 411 U.S. 216 (1973) (Fed.R.Civ.P. 58, as amended, requires that "judgment" be on separate document for purpose of determining when it is entered in computing time for taking appeal); *Arnold Tours, Inc.*, v. *Camp*, 400 U.S. 45 (1970) (Travel agents have standing to object to Comptroller of the Currency's decision allowing banks to provide incidental travel services).

Petitioners believe that this case is just the type for which comparable summary disposition is appropriate.

Respectfully submitted,

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January 31, 1975